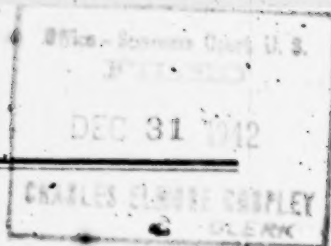




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IN THE  
**SUPREME COURT OF THE UNITED STATES**

OCTOBER TERM, 1942—NO. 327

FRED FISHER MUSIC CO. INC. and GEORGE  
GRAFF, Jr.,

*Petitioners,*

*against*

M. WITMARK & SONS,

*Respondent.*

ON WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS  
FOR THE SECOND CIRCUIT

**BRIEF FOR RESPONDENT**

ROBERT W. PERKINS,  
*Solicitor for Respondent.*

STUART H. AARONS,  
SIDNEY BARROWS,  
*of Counsel.*



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---

**BRIEF FOR RESPONDENT**

**The Agreements**

In both agreements the author assigned the original copyright and the renewal term. The 1910 agreement, made before the song was written, obligated the publisher to pay royalties, the rate being the same during the original and renewal terms (R. 26, 27).

Under the 1917 agreement, made after the song had been copyrighted and published for five years, the author for a lump sum released his royalties to the publisher, and appointed the publisher his attorney-in-fact to do all things necessary to secure the renewal copyright to the publisher (R. 31).

The Circuit Court of Appeals treated the action as one for specific performance (R. 84, 85). The order before the Court granted a preliminary injunction. The Court decided on two issues,—the validity of the agreements with respect to the renewal term and the adequacy of the con-

sideration for the 1917 agreement to support equitable relief. The adequacy of the consideration still remains for trial. Certiorari was sought only on the issue of the validity of the agreements.

### **The Issue**

Does the Copyright Act make null and void all dealings by the author beyond the original term of copyright if entered into prior to the twenty-eighth year of the original term? Is it impossible before the last year of the original term to make a valid agreement disposing of any interest in the renewal term?

### **Summary of Argument**

#### **1.**

The division of the copyright grant into an original and renewal term, with the right to the renewal term contingent upon survivorship, does not import any restriction on the right to alienate the renewal term while contingent. Insofar as assignments are covered in the Copyright Act of 1909, the implication is that all rights under copyright are assignable. There is nothing in Section 23 of the Act negating this. In the first proviso of this section the proprietor of the original term in the works covered is designated as the party entitled to the renewal term; in the second proviso covering other works, the author, if he be living, or his widow or children, if they be living, are designated as the parties entitled to the renewal term. This does not mean that such parties under either the first or second proviso cannot assign their right to the renewal term while it is contingent, and under the ordinary rules of law such right is assignable. No policy to the contrary is manifested in the statute.

## 2.

The report of the Congressional Committee dealing with Section 23 shows no such policy. The report was discussing the problems first, whether there should be a single term, or a double term, and, second, the length of term. It had been testified before the Committee that authors sometimes assigned their renewal term with the original term, and sometimes did not. The advantage to the author which led the Committee to recommend retaining the double term was to facilitate such transactions, and moreover, with the double term, an assignment of the copyright would pass only the original term, while with a single term, an assignment of the copyright would pass the entire interest. The report showed there was no intention to make the renewal term inalienable when it stated that the law should be framed as was the existing law, because all the authorities at that time agreed that under the existing law the contingent renewal term was assignable. All statutes, since the beginning of statutory copyright, were construed to permit the assignment of the contingent renewal term. The authorities give the same construction to the Act of 1909.

## Argument

### Introductory Statement

Petitioners present their case on the broad ground of the policy of the statute. They say that "Congress chose to treat the author as though he were the beneficiary of a spendthrift trust" (Brief, p. 36). They do not attack Respondent's rights on the common-law technicality that the renewal term cannot be assigned prior

to the last year of the original term because it does not come into existence until then. Their position would defeat all actions on agreements involving the contingent renewal term whether in law or in equity. So far as renewal rights are concerned, their position would invalidate not only the 1917 agreement, based upon a lump sum payment, but also the 1910 agreement, based upon the payment of royalties throughout the renewal as well as the original term. Until the twenty-eighth year of the original term, say Petitioners, only the original term can be disposed of, dealt in, or licensed, and if there are only a few years left in the original term, only those few years can be dealt in. They would taint with original sin all dealings in the renewal term prior to the twenty-eighth year of the first term (Brief, p: 37).

Petitioners' case rests on an alleged policy which they read into the Copyright Act to give to authors and their families an economic benefit in the twenty-eighth year of the original term "unfettered by prior commitments" (Brief, p. 12). We believe that an examination of the statute will show no such policy.

True, the exclusive right or monopoly granted by the Act is in two terms,—an original term and a renewal term, following the precedent of the Statute of Anne of 1709 (8 Anne, c. 19). The renewal term is not a present estate but is an expectancy or contingency depending upon the author's survivorship of the original term. In the Statute of Anne, and in our earliest statute, that of 1790 (1 Stat. 124), the author's right to the renewal was contingent on his surviving. If he did not survive, the monopoly of the copyright expired and his work went into the public domain. The Act of 1831 (4 Stat. 436) changed this only to the extent of providing that if the author did not

survive, his widow and children would have the renewal term. If they did not survive, the monopoly of the copyright expired and the work went into the public domain. This was continued in the Act of 1870 (16 Stat. 212), the Revised Statutes of 1873-1874 (Rev. Stat. §4948, *et seq.*) and the Act of 1891 (26 Stat. 1106). Finally, under the Act of 1909 (35 Stat. 1075), the same contingencies are provided with respect to the renewal term except that if the widow and children do not survive, the renewal term goes to the author's executors or, if there is no will, to his next of kin. If neither the author, widow, nor children survive, and there is no will nor next of kin, the monopoly of the copyright expires and the work goes into the public domain. Under this statutory scheme, the author, and the widow and children in their turn, have a contingent right in the renewal term. But that does not import any restriction on their right to assign what they have. Of course, if the author assigns the renewal term, but does not survive, the assignee, whose rights cannot be greater than the author's, will take nothing.

Petitioners argue that since copyright is the creature of statute, "the privileges extended and the persons to whom they are available must be determined by the provisions of the Copyright Law" (Brief, Point 1A). It is true that "copyright is the creature of the Federal statute passed in the exercise of the power vested in the Congress", *Fox Film Corp. v. Doyal*, 286 U. S. 123, 127, and that "the right of an author to a monopoly of his publications is measured and determined by the copyright act", *Holmes v. Hurst*, 174 U. S. 82, 85. But Petitioners cannot contend that all attributes of copyrighted property are found in the Copyright Act.

The Act creates the property but the ordinary principles of law determine those of its attributes not covered

by the Act. Thus a State may tax income derived wholly from copyrights, *Fox Film Corp. v. Doyal*, 286 U. S. 123; the ordinary principles of tenancy in common attach to copyrights, *Silverman v. Sunrise Pictures Corp.*, 273 Fed. 909 (C.C.A. 2d, 1921); *Carter v. Bailey*, 64 Me. 458 (1874); copyrights and renewal copyrights may be held in express, and in constructive trust, *Bisel v. Ladner*, 1 F. (2d) 436 (C.C.A. 3d, 1924); *Southern Music Pub. Co. Inc. v. Bibb Lang*, 10 F. Supp. 972, 974 (S. D. N. Y., 1935); *Sebring Pottery Co. v. Steubenville Pottery Co.*, 9 F. Supp. 383 (N. D. Ohio, 1934). The Copyright Act says nothing as to equitable title, tenancy in common, or income from copyrights, so the courts applied the principles governing other forms of property. Unless Petitioners can show that the Copyright Act, as a result of the words it uses or the policy it establishes, invalidates assignments of the renewal term prior to the twenty-eighth year of the original term, the ordinary rules as to the assignability of contingent interests will control. It is well settled that such interests are assignable. 4 Pomeroy, *A Treatise on Equity Jurisprudence* (1941) Sec. 1270 *et seq.* *In re Barnett*, 124 F. (2) 1005 (C.C.A. 2d, 1942); *Nugent v. Smith*, 202 App. Div. 279, 281, *affd.* 234 N. Y. 611 (1922).

## POINT I

**There is nothing in the Copyright Act of 1909 which restricts the alienation of the renewal term prior to the twenty-eighth year of the original term or which manifests any policy against such alienation.**

No language restricting assignments of the contingent renewal term, or evidencing any policy against such assignments, we submit, can be found in the Copyright Act

of 1909. On the contrary, the statute indicates that all rights which it secures are assignable.

**1. The provisions of the statute dealing with assignments indicate that the contingent renewal term is assignable.**

Assignments are dealt with in Section 8 and Sections 41 to 46 of the statute:

The first part of Section 8 reads as follows:

"That the author or proprietor of any work made the subject of copyright by this Act, or his executors, administrators, *or assigns*, shall have copyright for such work under the conditions *and for the terms specified in this Act*; \* \* \* (35 Stat. 1077). (Italics ours.)

The word "assigns" relates to the "author or proprietor" who "shall have copyright \* \* \* for the terms specified in this Act". "Terms" is in the plural and includes both terms mentioned in Section 23. That section defines the original term by stating:

"That the copyright secured by this Act shall endure for twenty-eight years from the date of first publication, \* \* \* (35 Stat. 1080)

It then defines the renewal term in two provisos. In each proviso the definition of renewal term is:

"a renewal and extension of the copyright in such work for the *further term* of twenty-eight years". (*ibid.*) (Italics ours.)

Obviously the "further term" representing the renewal in these provisos is included in the "terms" covered by Section 8 with its expressive use of the words "or as-

signs". There is no suggestion of any restriction on the assignability of the terms, whether original or renewal, vested or contingent, in being or in expectancy.

Sections 41 to 46, inclusive, deal with the assignment of copyrights in various phases\*. Nowhere is there any restriction on alienation except, perhaps, Section 44 making "void" as against a subsequent purchaser for value any assignment not recorded within three months after its execution. If Congress intended to lay down restrictions on the assignment of renewal copyrights while contingent, the natural expectation would be to find apt words to that effect among these provisions.

**2. The language of Section 23 does not restrict assignments of the contingent renewal term or evidence any policy against such assignments.**

Petitioners rely upon Section 23 of the statute. This section in no way indicates that the renewal term cannot be assigned prior to the twenty-eighth year of the original term. The word "void" is missing from this section. Equally missing, we submit, is any policy against anticipatory assignments of the renewal term. This section reads as follows:

\* Section 42 reads:

"That copyright secured under this or previous Acts of the United States may be assigned, granted, or mortgaged by an instrument in writing signed by the proprietor of the copyright, or may be bequeathed by will." (39 Stat. 1084.)

Petitioners seek to read the phrase "copyright secured" as covering renewal copyrights only after the author has "perfected" them (Brief, p. 17, footnote). Obviously no such limitation can be read into the phrase with respect to the original copyright, for it is freely assignable before it is taken out. *T. B. Harms v. Stern* (C.C.A. 2d, 1916), 231 Fed. 645; *Callaghan v. Myers*, 128 U. S. 617. The phrase is merely a comprehensive expression covering all interests in copyright and derives from the authority of Congress under the Constitution "to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". (Italics ours.)

“That the copyright secured by this Act shall endure for twenty-eight years from the date of first publication, whether the copyrighted work bears the author's true name or is published anonymously or under an assumed name:

*Provided*, That in the case of any posthumous work or of any periodical, cyclopedic, or other composite work upon which the copyright was originally secured by the proprietor thereof, or of any work copyrighted by a corporate body (otherwise than as assignee or licensee of the individual author) or by an employer for whom such work is made for hire, the proprietor of such copyright shall be entitled to a renewal and extension of the copyright in such work for the further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright:

*And provided further*, That in the case of any other copyrighted work, including a contribution by an individual author to a periodical or to a cyclopedic or other composite work when such contribution has been separately registered,\* the author of such work, if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then the author's executors, or in the absence of a will, his next of kin shall be entitled to a renewal and extension of the copyright in such

\* The words “when such contribution has been separately registered” were deleted by the amendment of March 15, 1940, c. 57, 54 Stat. 51, 17 U. S. C. A. §33 (Supp. 1942).

work for a further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright:

*And provided further, That in default of the registration of such application for renewal and extension, the copyright in any work shall determine at the expiration of twenty-eight years from first publication.*" (35 Stat. 1080)

Petitioners argue that the specific designation in the second proviso of the author and his family as the parties entitled to the renewal term means that they cannot assign the renewal before they have obtained it (Brief, p. 15). No such meaning can be read into this language. The Constitution designates only "authors and inventors" as entitled to "the exclusive right to their respective writings and discoveries". But no one contends that authors and inventors are prevented by this language from assigning their rights before the copyright or the patent issues. Moreover, if the designation of the author and his family in the second proviso of Section 23 creates a restriction on alienation, it would apply to the renewal term after it was obtained as well as before, a result which Petitioners disclaim.

To bolster their argument, Petitioners point out that in the first proviso in Section 23 the "proprietor" is designated as the party entitled to the renewal, and they seek to contrast the designation of the "proprietor" with the designation of the author and his family in the second proviso (Brief, p. 15).

The first proviso creates the renewal term for four specific categories of works; the second proviso creates the renewal term for all other works. "The first proviso merely provides exceptions to the second." *Shapiro, Bernstein & Co., Inc. v. Bryan*, 123 F. (2d) 697, 699 (C.C.A. 2d, 1941).

The statutes prior to the Act of 1909 did not make any such exceptions, and all works fell within the provisions of what corresponded to the second proviso. The language used in the previous statutes was substantially the same as that used in the second proviso of the Act of 1909, designating the author and his family as entitled to the renewal, and making their rights contingent on survivorship. See Appendix p. 1 *et seq.* The introduction into the Act of 1909 of the exceptions of the first proviso would hardly be sufficient to change the meaning of the language in the second proviso, which under the previous statutes had been construed not to import any restrictions on the alienability of the renewal term. (Point III *infra*.)

Moreover, it is important to see what is meant by the word "proprietor" in the first proviso. Examination will show that the word is limited to the proprietor of the original copyright.

Section 23 begins:

"That the *copyright* secured by this Act shall endure for twenty-eight years from the date of first publication . . . ." (Italics ours.)

Immediately following is the first proviso, as follows:

"*Provided*, That in the case of any posthumous work or of any periodical, cyclopedic, or other composite work upon which the *copyright* was origin-

ally secured by the proprietor thereof, or of any work copyrighted by a corporate body (otherwise than as assignee or licensee of the individual author)\* or by an employer for whom such work is made for hire, the *proprietor of such copyright* shall be entitled to a renewal and extension of the copyright in such work for the further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright." (Italics ours.)

The only correct construction of the words "proprietor of such copyright" here is *proprietor of the original copyright, i.e., of the original term*. In a case involving the fourth category of the first proviso, namely, a work made for hire, the Second Circuit Court of Appeals gave such construction to the word "proprietor". Circuit Judge Learned Hand, speaking for the Court, said:

"The simple meaning of the words is that when the employer has become *the proprietor of the original copyright* because it was made by an employee 'for

---

\* Petitioners make some point with respect to this parenthetical clause affecting corporate bodies. The language of the proviso here is as follows.

"That in the case \* \* \* of any work copyrighted by a corporate body (otherwise than as assignee or licensee of the individual author) \* \* \* the proprietor of such copyright shall be entitled to a renewal and extension of the copyright in such work. \* \* \*

The proviso is speaking of the corporate body as proprietor of the original copyright. Similarly the parenthetical clause refers to a corporate body which is the assignee of the original copyright. Obviously it was unnecessary to mention the author's survivorship in a case where only the original copyright has been assigned. Consequently there is no point to Petitioners' argument (Brief, p. 16) that survivorship of the individual author is not mentioned in the clause. But for the clause, a corporate assignee of the original copyright in a work by an individual author would be entitled to the renewal of the copyright. The parenthetical clause was necessary to prevent confusion with respect to works by an individual author which were assigned to corporations, and such works assigned to others than corporations.

hire, the right of renewal goes with it, unlike an assignment." (*Shapiro, Bernstein & Co., Inc. v. Bryan*, 123 F. (2) 697, 700 (C.C.A. 2nd, 1941).)

If instead of the proprietor of the original term the designation in the first proviso had been the proprietor of the renewal term, Petitioners might have gained some slight comfort from contrasting it with the designation of the author and his family in the second proviso. But the designation of the proprietor of the original term is another matter, and it in no way shows that the designation of the author and his family in the second proviso was intended to make it impossible for them to assign in advance the renewals to which they were "entitled". In both provisos the statute designates the party entitled to the renewal, but in neither proviso does it appear that he may not assign the right to which the statute "entitles" him.

The argument that the language of the second proviso makes the renewal term inalienable until the twenty-eighth year is exploded by comparing it with the language of the first proviso. Under the first proviso, *the proprietor of the original copyright* (say of a posthumous work or a work made for hire) :

"shall be entitled to a renewal and extension of the copyright in such work for the further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright".

In identical language, under the second proviso, the author of the work (say the song in litigation), if still living:

"shall be entitled to a renewal and extension of the copyright in such work for a further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright."

If the author of the song, because of this language, cannot assign or agree to assign the renewal term until he has made the application during the twenty-eighth year of the original term, then, *since the language is identical*, the proprietor of the original copyright of a work made for hire or of a posthumous work cannot assign or agree to assign the renewal term until he has made application during the twenty-eighth year. This would produce the curious result that the proprietor of a work made for hire who retained the original copyright could not agree to assign the renewal term to the author-employee, or any one else. Again the publisher of an author's posthumous writings who retained the original copyright, could not agree to assign the renewal term to the author's widow, or any one else. Obviously such agreements would contravene neither the language nor the policy of the statute. To support Petitioners' contention, it is necessary to read words into the statute which are not there, and to give opposing meanings to the same words in the same section.

\* Except for the difference, without significance, that in the first proviso the definite article precedes the phrase "further term", while in the second proviso the indefinite article is used.

This analysis also disposes of the support which Petitioners seek to get from the language of the second proviso:

“when application for such renewal and extension shall have been made”,

which they say means that such application can be made only by the party designated as “entitled” to the renewal, i.e., the proprietor in the case of the first proviso, and the author and his family in the case of the second proviso (Brief, pp. 35-36). Since proprietor means, as we believe we have demonstrated, the proprietor of the original copyright, it is certainly carrying matters to an extreme to say that under the first proviso no one but that proprietor may make the application and that the assignee of the renewal may not. Similarly, under the second proviso, we do not admit, although Petitioners indicate that we do (Brief, p. 17), that only the author or his family can make the application for the renewal. Obviously the author would not have to make out the application personally, or to go with it to the Copyright Office. He could have someone act for him. Obviously also in the case of co-authorship, an application in the name of one author would preserve the renewal term for both authors, *Southern Music Pub. Co. Inc. v. Bibb-Lang* (S. D. N. Y. 1935), 10 F. Supp. 972, 974, or in the case of next of kin, an application in the name of one would preserve the renewal term for all. *Silverman v. Sunrise Pictures Corp.* (C.C.A. 2d, 1921), 273 Fed. 909, 914. Although as Petitioners state, the opinion of the Assistant Attorney General (28 Ops. Attys. Gen. 162, 170 (1910)), and *White-Smith v. Goff* (C.C.A. 1st, 1911), 187 Fed. 247, are that the renewal must be in the author's name, and the practice of the

Copyright Office is in conformity, we doubt that the statute insists upon this formality. The statute does not state who shall make the application, but merely, "when application shall have been made."

But even if the application must be made in the author's name,\*\* we do not believe that the author must retain the beneficial, as well as the legal interest in the renewal term until after the application is made. In the cases just cited involving applications for renewals where there are co-authors or several next of kin, the legal title does not coincide with the equitable title.

Section 23 sets up the method of effecting renewals. Under the first proviso, where numerous authors might be involved, the right to the renewal is not contingent upon survivorship and the proprietor of the original term is designated as the party entitled to the renewal term. In the second proviso, where the right to the renewal

\*Petitioners (Brief, pp. 30, 31) stress the wording of the Act of 1870 which, in requiring that a copy of the record of the renewal term be published, use the words, "such person" in stating who shall cause the record to be published. "Such person" here refers to "the author" if he be living. But the language in the Act of 1870 is of no substantive significance. Under the Act of 1831, to perfect the renewal it was necessary to publish notice in a newspaper. Section 3 of the 1831 Act provided that in all renewals of copyright

"Each author or proprietor shall, within two months from the date of said renewal, cause a copy of the record thereof to be published in one or more of the newspapers printed in the United States." (4 Stat. 437)

(Obviously this is recognition that under the Act of 1831 the proprietor of the renewal copyright was expressly authorized to cause the necessary publication to perfect the renewal term. Petitioners completely ignore this provision when they contend that under the Act of 1831 the renewal term is unassignable (Brief, p. 29). We do not believe that the language of the Act of 1870 has any more significance than the language of the Act of 1831, and we emphasize the fact that in the Act of 1909 no one is named as the party to make the application because the language simply "when application . . . shall have been made".

\*\* An administrative advantage of insisting that the application for the renewal under the second proviso should be in the name of the author would be to make sure that the author is living.

term is contingent upon survivorship, the particular individuals in the sequence named are designated as being entitled to the renewal term. In both cases the final determination of the rights in the renewal term is subject to any contract which may have been made by the parties designated by the statute as being entitled to the renewal term.

## POINT II

The report of the Congressional Committee in dealing with Section 23 discussed the problems of a single term versus a double term and the duration of the copyright protection, and did not indicate that the contingent renewal term should be made inalienable. In recommending that "the law should be framed as is the existing law" the report negated any such intention.

Not finding sufficient support in the Copyright Act itself for their contention, Petitioners turn to the report accompanying the bill which became the Copyright Act. (H. R. Rep. No. 2222, 60th Cong., 2d Sess. (1909).) The report was that of the House Committee on Patents whose Chairman, Representative Currier, introduced the bill and report. The Senate Committee on Patents adopted the same report. (S. Rep. No. 1108, 60th Cong., 2d Sess. (1909).)

The report was a comprehensive one. It dealt with the philosophy of copyright, and gave a specific analysis of each section of the bill. With respect to the philosophy, the report said:

"In enacting a copyright law Congress must consider, as has been already stated, two questions:

First, how much will the legislation stimulate the producer and so benefit the public; and, second, how much will the monopoly granted be detrimental to the public? The granting of such exclusive rights, under the proper terms and conditions, confers a benefit upon the public that outweighs the evils of the temporary monopoly." (p. 7)

The report continued further on:

"Section 23 deals with the term of the copyright. Under existing law the copyright term is twenty-eight years, with the right of renewal by the author, or by the author's widow or children, if he be dead, for a further term of fourteen years. The act of 1790 provided for an original term of fourteen years, with the right of renewal for fourteen years. The act of 1831 extended the term to its present length. It was urged before the committee that it would be better to have a single term without any right of renewal; and a term of life and fifty years was suggested. Your committee, after full consideration, decided that it was distinctly to the advantage of the author to preserve the renewal period. It not infrequently happens that the author sells his copyright outright to a publisher for a comparatively small sum. If the work proves to be a great success and lives beyond the term of twenty-eight years, your committee felt that it should be the exclusive right of the author to take the renewal term, and the law should be framed as is the existing law, so that he could not be deprived of that right. —"

"The present term of twenty-eight years, with the right of renewal for fourteen years, in many cases is insufficient. The terms, taken together, ought to be long enough to give the author the exclusive right to his work for such a period that there would be no probability of its being taken

away from him in his old age, when, perhaps, he needs it the most. A very small percentage of the copyrights are ever renewed. All use of them ceases in most cases long before the expiration of twenty-eight years. In the comparatively few cases where the work survives the original term the author ought to be given an adequate renewal term. In the exceptional case of a brilliant work of literature, art, or musical composition it continues to have a value for a long period; but this value is dependent upon the merit of the composition. Just in proportion as the composition is meritorious and deserving will it continue to be profitable, provided the copyright is extended so long; and it is believed that in all such cases where the merit is very high this term is certainly not too long.

"Your committee do not favor and the bill does not provide for any extension of the original term of twenty-eight years, but it does provide for an extension of the renewal term from fourteen years to twenty-eight years; and it makes some change in existing law as to those who may apply for the renewal. Instead of confining the right of renewal to the author, if still living, or to the widow or children of the author, if he be dead, we provide that the author of such work, if still living, may apply for the renewal, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then the author's executors, or, in the absence of a will, his next of kin. It was not the intention to permit the administrator to apply for the renewal, but to permit the author who had no wife or children to bequeath by will the right to apply for the renewal." (pp. 14-15)

The Committee was here concerned chiefly with two problems,—first, should there be a single term, or an orig-

inal and a renewal term; and second, how long should the copyright protection endure. The Committee was dealing with these problems in the light of its desire to give "exclusive rights" which would "stimulate the producer and so benefit the public", but which would not create a "monopoly" . . . detrimental to the public".

### 1. The single term versus the double term.

The first paragraph quoted is devoted to the first problem,—a single or a double term. Petitioners rest much of their case on the following language in the first paragraph:

" . . . It was urged before the committee that it would be better to have a single term without any right of renewal, and a term of life and fifty years was suggested. Your committee, after full consideration, decided that it was distinctly to the advantage of the author to preserve the renewal period. It not infrequently happens that the author sells his copyright outright to a publisher for a comparatively small sum. If the work proves to be a great success and lives beyond the term of twenty-eight years, your committee felt that it should be the exclusive right of the author to take the renewal term, and the law should be framed as is the existing law, so that he could not be deprived of that right."

In thus arguing for the retention of the renewal term, we submit that the Committee had no thought of recommending that the renewal term be made inalienable.

When the Committee said, "It not infrequently happens that the author sells his copyright outright to a publisher for a comparatively small sum", the Committee was referring to the sale of the original copyright without

the renewal. Much of the fallacy in Petitioners' brief stems from their attempt to interpret this sentence as referring to the sale of the original and renewal copyright (Brief, p. 22). In thus misinterpreting the words of the Committee, Petitioners fall into a contradiction. In straining to find in the report an intent to make the renewal term inalienable, Petitioners give a construction to the report which would mean that the renewal term was "not infrequently" assigned under the then existing law. This of course runs squarely counter to a fundamental point in Petitioners' brief that under the then existing law assignments of the renewal term were void (Brief, p. 29 *et seq.*).

When the Committee said that it was "to the advantage of the author to preserve the renewal period", the Committee had in mind that authors frequently sold the original copyright without the renewal term. The courts and the textwriters had given much attention to the interpretation of assignments from authors to publishers to determine whether the language used in the assignments passed the original copyright only. The authorities held that it was a question of the intent of the parties as expressed in the assignment, and that an assignment of "the copyright" did not carry with it an assignment of the renewal term. *Pierpont v. Fawle* (1846), 19 Fed. Cas. 652; Morgan, *The Law of Literature*, Vol. II (1875), 228; Ellsworth, *Copy-Right Manual* (1862), 29. See these and other authorities discussed, *infra*, Point III, subd. 5.

Moreover, the Committee had in mind the testimony before it in hearings on certain bills introduced prior to the bill which became the Copyright Act of 1909. (Hearings before Committee on Patents on H. R. 19553, 59th Cong., 1st Sess. (June 6, 7, 8 and 9, 1906); id. 2d Sess.

(December 7, 8, 10 and 11, 1906); Hearings before Committee on Patents on *pending bills to amend and consolidate the acts respecting copyright*, 60th Cong., 1st Sess: (1908.) It learned from these hearings that sometimes authors assigned the renewal term with the copyright, and sometimes they did not. Thus, in the case of composite works\*, it was testified that the authors usually assigned their renewal rights with the original copyright, although the witness pointed out the difficulties in the situation because the publisher would not secure the renewal under the assignment if the author did not survive. This testimony is as follows:

"Mr. Hale.† \* \* \* These joint authors of composite works have always been treated by publishers as having the right of renewal, and those books have always been renewed by virtue of the right of the authors, the men who compiled them. That is the only way under the present law that a proprietor can get the renewal term. The contract covers it usually, but they get it from the author.

"Representative Currier. In the case of a composite work, does not the contract always cover the renewal period? Would you think anybody would employ a whole lot of authors to create a composite work and not, by contract, provide for the renewal period?

"Mr. Hale. But it is only possible to cover the right of renewal of the actual author. The right of renewal is contingent. It does not vest until the end. If he is alive at the time of renewal, then the original contract may pass it, but his widow or children or other persons entitled would not be bound by that contract." (Hearings (1908), p. 77.)

\* It should be noted that under the statutes prior to the Act of 1909 there was no distinction between composite and other works.

† W. B. Hale, representing the American Law Book Company, wrote the article "*Copyright and Literary Property*" published in 13 *Corpus Juris* 936 (1917).

With respect to other classes of works, one witness testified that the assignment included the renewal term at times, but not often:

"Mr. Hinshaw (Representative). Are these contracts for royalty made to include a possible extension of the copyright?"

"Mr. Ogilvie (Witness). Not generally; because the author may be dead when the time for the renewal comes.

"Mr. Currier. But it can be renewed then by his widow.

"Mr. Ogilvie. But they do not do it generally.

"Mr. Currier. I should suppose that in almost all cases under *the existing law* they would get a renewal.

"Mr. Ogilvie. They do at times, but not often."  
(Italics ours.) (Hearings (1906), 1st. Sess., p. 47.)

An interesting illustration was brought to the attention of the Joint Committee by Representative Currier himself:

"Representative Currier. Mr. Clemens told me that *he sold the copyright* for Innocents Abroad for a very small sum, and he got very little out of the Innocents Abroad until the twenty-eight-year period expired, and then *his contract did not cover the renewal period*, and in the fourteen years of the renewal period he was able to get out of it all of the profits." (Italics ours.) (Hearings (1908), p. 20.)

Later in the same day Mr. Currier remarked:

"Representative Currier. Representing the authors, then, do you not think it is in the interest of the authors to have a renewal period? If you were going to give a hundred years, would you not divide

that, giving one term, and then a renewal term? Do you not think it would be to the advantage of the authors, speaking solely for the authors, to (have) a renewal period?

"Mr. Johnson. I have never considered that as being a matter of any importance one way or the other.

"Representative Currier: As I said here to-day, when you, perhaps, were not present, Mr. Samuel Clemens told me he found it of very great importance to him; that *he sold the copyright of 'Innocents Abroad' for a very small sum*, and all he ever got out of it, practically, was the *renewal period*". (Italics ours.) (Hearings (1908), p. 62.)

The example of "Innocents Abroad" had great effect. In 1907 Chairman Currier and the Committee had sponsored a bill providing for a single term of life and thirty years (*infra*, p. 28). But here in 1908, Chairman Currier was asking the witness whether he did not

"think it would be *to the advantage of the authors, speaking solely for the authors, to (have) a renewal period*". (Italics ours.)

To prove his point Chairman Currier was telling the Committee that Samuel Clemens

"*sold the copyright for Innocents Abroad for a very small sum* \* \* \* his contract did not cover the renewal period, and in the fourteen years of the renewal period he was able to get out of it all of the profits". (Italics ours.)

Substantially this same language was used in the report of Chairman Currier and the Committee in 1909 when the report said, reversing the stand taken in 1907,

"Your Committee, after full consideration, decided that it was distinctly *to the advantage of the author to preserve the renewal period*". (Italics ours.)

and when the report said,

"It not infrequently happens that the author *sells his copyright outright \* \* \* for a comparatively small sum*". (Italics ours.)

It is apparent that Chairman Currier and the Committee had in mind "*Innocents Abroad*", and it was on the basis of that example that they rejected the single term they had previously sponsored and recommended the retention of the double term.

The distinct advantage to the author,\* which the Committee saw in the retention of the double term was to make it easy for him, if he wished, to dispose of only the original copyright, and to keep for himself the renewal term. Moreover, if there were but one term, a sale of the copyright would pass the author's entire interest. But if there were two terms, a sale of the copyright would pass only the original term. The Committee had these considerations in mind and not the entirely different proposition that the renewal term should be made inalienable.

No author, and no one of the numerous representatives of authors who appeared before the Committee, made any suggestion that the renewal term should be made inalienable. Only one person, a lawyer, who stated that he was merely a private citizen, not representing

\* Copyright being indivisible (*Goldwyn Pictures Corporation v. Howells Sales Co.*, 282 Fed. 9, (C.C.A. 2nd, 1922); *M. Witmark & Sons v. Pastime Amusement Co.*, 298 Fed. 470, 474 (D.C.S.C. 1924) *affd.*, 2 F. (2d) 1029 (C.C.A. 4th, 1924)), if there were but a single term, technical difficulties would confront an author who wished to dispose of the first portion of the term and to retain the remaining portion. Moreover, as the report indicates in the next paragraph, the public obtains an advantage from the double term because many copyrighted works, which are not renewed, fall into the public domain at the end of the original term.

any interest, brought up the question. He suggested that there should be, in addition to the original term, two renewal terms, and in discussing the question whether if this were done, publishers would not contract with authors for both renewal terms, he said:

"Mr. Jenner. It is never done, and I have some doubt about whether it legally could be done. But I should be glad to see that so provided for that it could not be done under the law.

"Representative Law. Then put it in the bill itself.

"Mr. Jenner. Put it in the bill itself, and say that it cannot be done, so that the author is certain to have that extension as a provision for his age or a provision for his widow and his children. (Applause.)" (Hearings (1908), p. 128.)

That Mr. Jenner's "doubt" as to the legality of an assignment of a renewal term under the law then existing was entirely unjustified is shown, we believe, in Point III, subd. 5 of this brief. And if he meant to refer to the assignments of renewal terms under the existing law when he said "it is never done," he not only is contrary to Witnesses Hale and Ogilvie and the remarks of Chairman Currier, and to all the authorities, but he belies all reason for his suggestion that the renewal terms should be made inalienable.

But Mr. Jenner's suggestion, which related to an entirely different bill, was not followed. If the Committee had intended to make the renewal term inalienable, it would have "put it in the bill itself", and have said "that it cannot be done." But instead the Committee stated that the law should be framed "as is the existing law". The Committee knew that under the existing law anticipatory assignments of renewal terms were made, and as

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we believe we demonstrate later, the existing law was clear that there were no restrictions against such assignments:

## 2. Exclusive right.

Petitioners also rely upon the words "exclusive right" in the clause in the first paragraph of the report dealing with Section 23. This clause reads:

"your committee felt that it should be the exclusive right of the author to take the renewal term. \* \* \*

There is no significance in the phrase "exclusive right". All the author's rights are exclusive. The phrase comes from the Constitution and the statutes creating copyright. It is used to show that the rights secured to authors are not "non-exclusive". The Committee report in the paragraph immediately following makes similar use of the phrase when it says:

"The terms, taken together, ought to be long enough to give the author the exclusive right to his work for such a period \* \* \*"

An exclusive right is a right to exclude others acting without the owner's permission and is not at all a right which can be exercised only by the owner.

## 3. Duration of the term.

The first paragraph of the report dealing with Section 23 rejected a single term for the life of the author and fifty years in favor of a double term. The second paragraph turns to the question of duration. It was concerned that the author should receive protection throughout his life. It states that the then existing term of twenty-eight years, with the right of renewal for fourteen years, was

in many cases insufficient, and that the terms, taken together, ought to be long enough to give the author the exclusive right to his work

*"for such a period that there would be no probability of its being taken away from him in his old age, when, perhaps, he needs it the most." (Italics ours.)*

The dissenting opinion below finds in this language an intent to make the renewal term inalienable (R. pp. 92, 93). But if such had been the Committee's intent, it would not have used the word "probability" in this clause. Properly read in its context, this clause is solely concerned with the length of the terms. What the Committee meant was "taken away from him" by expiration, not by assignment. Substantially the same language was used in a report submitted by the same Congressman, Representative Currier, in a preceding session of Congress, when he and his Committee were recommending a single term consisting of life and thirty years. That report reads in part as follows:

*"Your committee believe that it is better to have a single term without any right of renewal, and that that term should certainly cover the lifetime of the author. If an author is entitled to any protection on his work, that should not be taken away from him in his old age, when perhaps he needs it most." (Italics ours.) (H. R. Rep. No. 7083, 59th Cong., 2nd Sess., January 30, 1907, p. 13.)*

This language, used to support a proposal for a single term, measured by the life of the author, related solely to the duration of copyright. It had no relation to any restriction on the author's right to deal in his property. The substantially identical language used by the same

Congressman in his later report on the 1909 bill similarly related solely to the duration of the term and had no reference to any restriction.

**4. "The law should be framed as is the existing law."**

The Committee report makes constant reference to existing law, pointing out the instances in which the bill changes the existing law, and those in which the existing law is retained. At the beginning of the discussion of Section 23 the report says:

"Under existing law the copyright term is twenty-eight years, with the right of renewal by the author, or by the author's widow or children, if he be dead, for a further term of fourteen years. The act of 1790 provided for an original term of fourteen years, with the right of renewal for fourteen years. The act of 1831 extended the term to its present length."

Later on in this discussion, the Committee points out that the bill

"makes some change in existing law as to those who may apply for the renewal".

For our purposes, the vital reference to "existing law" is in the very sentence so heavily relied upon by Petitioners, where the report says:

"If the work proves to be a great success and lives beyond the term of twenty-eight years, your committee felt that it should be the exclusive right

\* The report states that in the bill it followed existing law in Sections 1a, 4, 6, 8—"first part", 23, 25(a), 25(b) first and second subds., 31(a), (b), (c), 31(d) second subd., 33, 34, 37, 38, 40, 41 and 47. It states it changed existing law in the following Sections: 9, 12, 13, 14, 20, 21, 23 as to who may apply for renewal, 25(b), 28, 31d. first and third subsecs. and subd. fourth, 36, 39, 50, 61. It designated as new provisions the following Sections: 1b, c, d, e, 2, 8 the "previso", 25b. third subd., 25(c), (d), 32, 35 and 49.

of the author to take the renewal term, and *the law should be framed as is the existing law*, so that he could not be deprived of that right." (Italics ours.)

The Committee made the statement that "the law should be framed as is the existing law" in the light of the testimony at the hearings which was inconsistent with any restrictions in law on the alienation of the renewal term. Presumably the Committee also made the statement in the light of the authorities which were unanimous at that time that under the existing law the contingent renewal term was alienable.

### POINT III

**From the beginning of statutory copyright there was no restriction on the alienability of the renewal term, and this was the "existing law" at the passage of the Act of 1909.**

A brief historical survey of copyright legislation shows that from the beginning of statutory copyright the division of the copyright grant into two terms, an original term and a contingent renewal term, was never accompanied with a restriction on the alienation of the contingent renewal term.

#### 1. Statute of Anne, 1709.

Statutory copyright began with the Statute of Anne in 1709. (8 Anne c. 19). *Holmes v. Hurst*, 174 U. S. 82, 85. *MacGillivray, The Law of Copyright* (1902), 4. That

statute created the pattern of two terms of copyright, an original term and a renewal term contingent upon the author's survivorship. The author was given an original term of fourteen years and a renewal term of an additional fourteen years, expressed as follows:

... \* \* that the author of any book or books already composed, and not printed and published, or that shall hereafter be composed, and his assignee or assigns, shall have the sole liberty of printing and reprinting such book and books for the term of fourteen years, to commence from the day of the first publishing the same, and no longer;

"Provided always, That after the expiration of the said term of fourteen years, the sole right of printing or disposing of copies shall return to the authors thereof, if they are then living, for another term of fourteen years." (8 Anne c. 19). (Italics ours.)

The renewal term was contingent on survival by the author, but the author's right to alienate it at any time was in no way restricted.

It was expressly held that under the Statute of Anne the contingent right of renewal was assignable, and if the author survived the original term, he was bound by his assignment. *Carnan v. Bowles*, 2 Bro. C. C. 80, 29 English Reports (Full Reprint) 45 (1786). In that case the author of a book sold it to the plaintiff-publisher. After the fourteen year term of the original copyright, the author attempted to sell the rights in the book to the defendant, a competing publisher. The plaintiff, claiming the renewal rights, moved for an injunction to restrain the defendant from publishing the book. The defendant, anticipating by a century and a half Petitioners' points

in the case at bar, argued that the renewal term was designed to protect authors against their own acts, and that the Statute gave the renewal to "the authors" but not to their assigns. Defendant argued:

"• • • The expression in the act meant to secure something to authors, *even against their own acts*. It gives the right to authors and their assigns during the first fourteen years, and no longer, and then, by the proviso, the right shall *return to the authors* (not their assigns), if living; so that it is a *personal bounty to the authors only*. In selling the right, the author sells all that is in him, not the contingent right that may return to him." (Italics partly ours.) (2 Bro. C. C. 82.)

In reply, the plaintiff argued:

"With respect to the author's second term, he has an absolute and a contingent right; they are both capable of being disposed of. The counsel on the other side have stated nothing in the act to make a difference between them. The *return* is only between the public and the author, not between him and his assignee. There are no negative words in the act to prevent his assigning that, as well as his other rights. In many cases, if he could not assign it, the disability would be productive of great inconvenience." (2 Bro. C. C. 83.)

Lord Chancellor Thurlow held for the plaintiff and said:

"With respect to the first point, it strikes me that the contingent interest must pass by the word *interest* in the grant. • • • It must, I think, be considered as conveying his whole right." (2 Bro. C. C. 83-84.)

Maugham, in his work on *Laws of Literary Property* (1828); after discussing this case, thus states the rule under the Statute of Anne:

"If an author who has assigned his right, outlive the first fourteen years, \* \* \* his assignee, by the general assignment, will have the benefit of the resulting term, fourteen years, \* \* \* " (p. 73.)

The right to assign the renewal term at any time under the Statute of Anne was recognized by Lord Chancellor Eldon in *Rundell v. Murray*, Jacob Reports 310 (1821), 37 English Reports (Full Reprint), page 868.

## 2. Resolution of the Continental Congress of 1783 and early state statutes.

The Continental Congress on May 2, 1783, passed a resolution recommending copyright legislation by the separate states. This resolution retained the pattern fixed by the Statute of Anne of an original term of fourteen years with a renewal term of an additional fourteen years contingent on the author's survival. The resolution was as follows:

"RESOLVED, That it be recommended to the several states, to secure to the authors or publishers of any new books not hitherto printed, being citizens of the United States, and to their executors, administrators and assigns, the copyright of such books for a certain time not less than fourteen years from the first publication; and to secure to the said authors, if they shall survive the term first mentioned, and to their executors, administrators and assigns, the copyright of such books for another term of time not less than fourteen years, such copy or exclusive right of printing, publishing and vending the same, to be secured to the original

authors, or publishers, their executors, administrators and assigns, by such laws and under restrictions as to the several states may seem proper." (Journals of Congress, May 2, 1783.)

Some states had already enacted such legislation. All of the remaining states, except Delaware, thereupon passed statutes as suggested by the Continental Congress. Noah Webster, *A Collection of Papers* (1843), 173; Solberg, *Copyright Enactments of the United States* (1906), 11 *et seq.*

### 3. Copyright Act of 1790.

The adoption of the Constitution conferred upon Congress the function of legislating upon copyright. Congress acted promptly and the first federal copyright statute was passed on May 31, 1790. That statute also followed the model of the Statute of Anne. Weil, *American Copyright Law* (1917), 18; Drone, *A Treatise on the Law of Property in Intellectual Productions* (1879), 1. It gave an original term of fourteen years, and a renewal term of an additional fourteen years, contingent upon the author's survival. It read:

" \* \* \* the author and authors of any \* \* \* book or books \* \* \* , being a citizen or citizens of these United States, or resident therein, and his or their executors, administrators or assigns, shall have the sole right and liberty of printing, reprinting, publishing and vending such \* \* \* book \* \* \* , for the like term of fourteen years from the time of recording the title thereof in the clerk's office as aforesaid. And if, at the expiration of the said term, the author or authors, or any of them, be living, and a citizen or citizens of these United States, or resident therein, the same exclusive right shall be continued to him or them, his

or their executors, administrators or assigns, for the further term of fourteen years: *Provided*, he or they shall cause the title thereof to be a second time recorded and published in the same manner as is herein after directed, and that within six months before the expiration of the first term of fourteen years aforesaid." (1 Stat. 124.)

This statute was enacted by Congress after the decision in *Carnan v. Bowles*, *supra*, that the Statute of Anne put no restrictions upon the alienation by the author of his contingent renewal right. The Act of 1790 contained certain formal words with respect to the renewal term which Petitioners contend differentiate it from other acts. These words do not appear in the Statute of Anne, nor in the Act of 1831. Their effect will be discussed in connection with the Act of 1831 immediately following.

#### 4. Copyright Act of 1831.

In 1831 a new copyright act was passed. Again the model of the Statute of Anne and the 1790 Act was followed. The 1831 Act read:

"That . . . the author or authors of any book or books, . . . and the executors, administrators, or legal assigns of such person or persons, shall have the sole right and liberty of printing, reprinting, publishing, and vending such book or books, . . . for the term of twenty-eight years from the time of recording the title thereof, in the manner hereinafter directed.

"Sec. 2. *And be it further enacted*, That if, at the expiration of the aforesaid term of years, such author, . . . be still living, . . . or being dead, shall have left a widow, or child, or children,

either or all then living, the same exclusive right shall be continued to such author, . . . or, if dead, then to such widow and child, or children, for the further term of fourteen years: *Provided*, That the title of the work so secured shall be a second time recorded, and all such other regulations as are herein required in regard to original copyrights, be complied with in respect to such renewed copyright, and that within six months before the expiration of the first term." (4 Stat. 436.)

Here again were the two terms of copyright, the original term, and a renewal term contingent upon survival. The original term was increased from fourteen to twenty-eight years. The renewal term was kept at fourteen years, and its contingent nature was retained. However, under the previous legislation there was no renewal copyright unless the author survived the original term, and if he did not survive, the work went into the public domain. Under the Act of 1831 if the author did not survive the original term and his widow or children did, the work did not go into the public domain but the renewal copyright accrued to them. There was no change in the assignability of the renewal term. Of course, if the author assigned the renewal term, but did not survive the original term, his assignee would take nothing because by the language of the statute the author would take nothing unless he survived. In this respect, the Act of 1831 was just the same as the Act of 1790. But if the author survived, there is nothing in either statute indicating that the assignee could not hold the author to his assignment, or agreement to assign.

Petitioners, however, contend that the Act of 1831 made a change in the law as to the assignability of the renewal term. They point out that the renewal provision

of the Act omits the formal words of assignability contained in such provision of the Act of 1790. The language in the Act of 1831 is

“if, at the expiration of the aforesaid term of years, such author, \* \* \* be still living, \* \* \* the same exclusive right shall be continued to such author, \* \* \* for the further term of fourteen years:”

In the Statute of Anne the original term was given to the “author \* \* \* and his assignee or assigns”; but the renewal term was given to the author without any mention of the word “assigns”. In the Act of 1790 the original term was given to the “author \* \* \*, and his \* \* \* executors, administrators, or assigns” and the renewal term was given to the author “his \* \* \* executors, administrators or assigns.” In the Act of 1831 the original term was given to the “author \* \* \* and the executors, administrators, or legal assigns” and the renewal term was given to the author without any mention of assigns. Under all three statutes, the renewal term was construed to be assignable while contingent. The inclusion of the formal word “assigns” in the provisions respecting the renewal term, or its omission, is without significance unless, perhaps, as is said in the opinion of the majority below, the omission in the Act of 1831 was to make it clear that the rights of the widow and children, there created for the first time, were superior to the rights of the assignee holding an anticipatory assignment from the author, if the author did not survive (R. 78).

Petitioners’ argument defeats itself. No one would contend that the omission of the formal words of assignability from the statute would restrict the author from

assigning the renewal term after it has vested. But their omission has no more significance with respect to the assignment of the renewal term before vesting than after vesting.\*

That Congress, in enacting the Copyright Act of 1831, had no intention of changing the law by restricting the alienation of the renewal right but was concerned with other things, appears from the report of the Judiciary Committee of the House of Representatives sponsoring the legislation. The bill which became the Act of 1831 was drafted by Representative Ellsworth who introduced it in the House, together with the report (Noah Webster, *A Collection of Papers* (1843), 177). The purpose of the bill was stated in the report as follows:

"It has been the aim of your committee in preparing the accompanying bill, . . . chiefly to enlarge the period for the enjoyment of copy-right, and thereby to place authors in this country more nearly upon an equality with authors in other countries.

. . . . .

"In the United States, by the existing laws, a copy-right is secured to the author, in the first instance, for fourteen years; and if, at the end of that period, he be living, then for fourteen years more, but, if he be not then living, the copy-right is determined, although, by the very event of the death of the author, his family stand in more need of the only means of subsistence ordinarily left to them. . . .

. . . . .

\* Of course, in so far as Petitioners might argue that the word "assigns" does not appear in Section 23 of the Act of 1909 with respect to the author's right of renewal, they are confronted by the provisions of Section 8 of that Act.

"This bill secures to the author a copy-right for twenty-eight years, in the first instance, with a right of renewal for fourteen more, if, at the end of the first period, the author be living, or shall leave a family. It is believed that the provisions of the bill are not too liberal, and that Congress ought not to do less than is proposed. Even this is less than is done in any one of the European States referred to." (Register of Debates in Congress, Vol. VII, Appendix CXIX-CXX)

The dissenting opinion below makes much of a sentence which appears in this report in connection with the discussion of the duration of the copyright (R. pp. 91, 92). The report here reads:

"Your committee do not perceive any reason for denying to authors the protection of the law, to the extent proposed. There is no serious danger of a monopoly. The question is, whether the author or the bookseller shall reap the reward. It is for the interest of the author to supply the market upon such terms as will ensure the greatest sale; and he will always do this."

Obviously the Committee was here concerned with the chief problem of the legislation, the extension of the original term of the monopoly from fourteen to twenty-eight years. The language:

"The question is, whether the author or the bookseller shall reap the reward:"

had nothing at all to do with alienation. It merely stated the problem of how long the copyright protection should be and shows the position of the author after the copyright expired and the work fell into the public domain.

At that point booksellers would be able to exploit the work without any obligation to pay royalties to the author. As the context clearly shows, the Committee was not discussing the question whether the author could assign the renewal term to a bookseller. In fact it was not discussing the renewal term at all but merely the enlargement of the original term from fourteen to twenty-eight years.

A similar commentary on the problem of duration of the copyright monopoly was made in a report accompanying a copyright bill introduced in the Senate in 1907. That report says:

"That the *duration of the term* is a question not so much between the author and the reading public (who get his book at the outset and do not get it any more completely after than during the term) as between the author with his one publisher who pays him something for his work and the other publishers who may wish to publish it without paying him anything." (Italics ours.) (S. Rep. No. 6187, 59th Cong., 2d Sess. (1907), 8.)

**5. The authorities under the Copyright Act of 1831 and subsequent statutes, constituting the "existing law" at the passage of the 1909 Act, were unanimous that there was no restriction on the alienability of the renewal term.**

Proof that nothing in the Act of 1831 restricted or was intended to restrict the alienation of the renewal term is found in the writings of Representative Ellsworth, who was the author of the Act. In 1862, after he retired from the Supreme Court of Errors of Connecticut, he wrote "Copy-Right Manual" in which he said, page 29:

"After renewal, the renewed term of the copy-right has all the qualities of property in the person or persons obtaining the renewal, as fully as the first

term had in the author or proprietor who obtained that term. Before the renewal takes effect, there is nothing but a possibility in the persons or person who shall live to renew; which possibility, perhaps, is not capable of being alienated as property, unless, possibly, by the author himself, he being the owner of the manuscript; but if a sale cannot in law be made at that time, *those who are anticipating this possible interest may bind themselves, by covenant, that whatever interest they may live to acquire, shall become the proper estate of the person so purchasing,—which covenant will be enforced in a court of equity.* (Italics ours.)

“We may here dispose of a question sometimes made between authors and those who hold under them by purchase of the copyright. Does a sale of the copyright carry with it a right to *renew* at the expiration of the existing copyright, or is the effect of the sale to be confined to the first term of the book? This must depend upon a fair and just interpretation of the agreement between the parties. It *may* certainly be included and enforced in equity, but it need not be included. This possibility certainly may be contracted for in purchasing the copyright, but it is not so of necessity, nor of course, nor *prima facie*. The mere sale of a copyright already obtained would not seem to embrace anything more than the copyright mentioned in the sale. That satisfies the terms of the sale, and courts are not inclined to a forced construction, on this delicate point, when it could easily have been made clear and certain, if more than the existing copyright was intended. Lord Eldon said, in *Burr v. Murray*, *Jacobs R.* 315: ‘I conceive that an author will not be taken to have assigned his contingent right in case of his surviving the fourteen years, unless the assignment is so expressed as to purport to pass it.’” (Italics the authors.)

Ellsworth was only one of the numerous authorities holding that under the Act of 1831 the renewal term was assignable before it took effect. The question came up in *Pierpont v. Fowle* (C. C. Mass., 1846), 19 Fed. Cas. 652. Although the Court held that the language of the particular instrument did not convey the renewal term, it recognized that if the author expressed his intention clearly, the renewal term would pass. The Court said:

"In the next place, it is the author and not the assignee, to whom the extension of the right is eo nomine given, by the statute of Anne, as well as the acts of congress. Jeremy, Eq. Jur. p. 318. By that, 'the sole right shall return to the author for fourteen years more, if then living.' So by 54 Geo. III., after the enlarged term of twenty-eight years is conferred on an author or his assigns, it is he alone on whom fourteen years more is conferred, if he be then living. Id. So here the copyright is in the act of 1790 and 1831, given to the author alone, and to others, only, who purchase it from him. By construction, then, we should not extend it beyond the words and design of the statute, made to benefit authors, *unless it seems to be actually meant by the author to be transferred forever, and including any future contingency, and a clear and adequate consideration paid for the extended term.* See *Wilson v. Rousseau*, 4 How. (45 U. S.) 677, opinion of minority; and *Washburn v. Gould* (Case No. 17,214); *Woodworth v. Sherman* (Id. 18,019)." (19 Fed. Cas. 659.) (Italics ours.)

The Supreme Court, in *Paige v. Banks*, 13 Wall. 608, specifically held, we submit, that the contingent right of renewal under the Act of 1831 was assignable. Petitioners contend in their brief, page 44, that the Copyright Act of 1790 was controlling in this case. We disagree.

The facts appear clearly in the decision of Judge Blatchford, in the trial court, 18 Fed. Cas. 1001.

In 1821 Paige, a law reporter, agreed to furnish reports of the Chancery Court in New York to his publishers. The publishers agreed to pay \$1,000 for every volume published. Paige delivered a particular volume to his publishers, who copyrighted it in 1830. Thus it is true that the work was copyrighted under the Act of 1790, which created an original term of fourteen years, with a right of renewal, contingent upon the author's survivorship, of fourteen additional years. However, the Act of 1831, passed one year after this copyright was taken out, by Section 16 extended the original term of then subsisting copyrights to twenty-eight years, and in addition gave a renewal term of fourteen years contingent on survivorship. The original term of the copyright, thus lengthened by the Act of 1831, expired in 1858. The litigation was over the fourteen-year renewal period which began in 1858 and which was granted by Section 16 of the Act of 1831.

The Court below thus expressed the issue:

*"It is claimed that Mr. Paige, by proper steps taken, renewed the copyright of such first volume under the act of 1831, for his own benefit, for the term of fourteen years from the 5th of January, 1858, and that the assignors to the defendants, by like proper steps, renewed such copyright under said act, for their own benefit, for the same term."* (18 Fed. Cas. 1002.) (Italics ours.)

The Court held that Paige's agreement had transferred the renewal term to the publishers.

In the Supreme Court, appellant attempted to distinguish the Act of 1831 from the Act of 1790 by pointing

out the omission of the formal words "executors, administrators or assigns" from the renewal provisions, saying:

"The act of 1831 which created this new term (the renewal term), gives it specifically to the author if living, to *his family*, if he is dead. *Assignees are not mentioned in it, nor provided for.*" 13 Wall. 612. (Italics partly ours.)

The Supreme Court, however, affirmed the decision of the trial court and held that Paige's agreement passed the entire interest in his work, including the renewal term.

The text writers were unanimous that the Act of 1831 imposed no restrictions on the alienability of the renewal term. We have already quoted from Ellsworth. Similarly, George Ticknor Curtis, whose "Treatise on the Law of Copyright", published in 1847, became standard, says:

"In like manner, the question may arise, whether a general assignment of copyright, by the author, will deprive his representatives of the additional term of fourteen years, given by the act of congress of 3d February, 1831, Sec. 2; or whether the author himself has any power over this additional term, so far as the interests of his representatives are concerned: The statute provides that the author, if living at the expiration of the first term of twenty-eight years, shall have a further term of fourteen years, on making a new entry for that purpose. *This contingent interest the author may undoubtedly assign.* But if the author is not living at the end of the first term, the additional term vests in his widow and child, or children, living at the time. It is not easy to see how the author can dispose of this interest. It is not created for him, but for his family; it vests only in case of his death, and the policy of the statute, it seems to me, has removed it from his control." (p. 235) (Italics ours.)

The Copyright Act of 1870 (16 Stat. 212) made no change in the law with respect to the renewal term.\* The authorities writing after the passage of this Act were unanimous that the contingent renewal term was assignable.

2 Kent's Commentaries (12th Ed. by Holmes, 1873), at page 510, clearly indicates that the assignment by the author of his renewal term is effective if he survives the original term.

Morgan in The Law of Literature (1875), in Vol. 2 at page 229 states:

"The assignment of a 'copyright', in general terms, will be referred to what was in existence at the date of the assignment, and not to any future contingency; and it will in no case be construed to operate as an assignment of a second and future renewal or term, unless the author so expressly state it, or unless it seems so actually to be meant by the author, beyond a reasonable doubt; as when the contract of assignment, or sale uses language looking beyond the existing copyright; such as referring to 'all the 'interest' in the matter, or to the 'manuscript' thereof, or some term in itself more expressive than 'copyright'."

Spalding in The Law of Copyright (1878), at page 111, states:

"An assignee alone cannot take out a second or extended term unless he has clearly and unequivocally contracted and paid for it, and is entitled to be protected in it in equity rather than according to any mere technical rule of law".\*\*

\* No change was made in the renewal term in the Revised Statutes of 1873-4 (Rev. Stat. §4948 ff.) or in the Act of 1891 (26 Stat. 1106).

\*\* This book contains contract forms some of which limit the rights granted to the original copyright and some of which include the renewal term (pp. 37, 38, 40).

Drone in *A Treatise on The Law of Property in Intellectual Productions* (1879), at page 326, states:

"It is reasonably clear that the copyright for the additional term will vest only in the author, if he be living. But there appears to be no reason why he may not divest himself of the right thus reserved for him, either by parting absolutely with his entire interest in a work, or by an agreement to convey the copyright for the additional term when it shall be secured. In the former case, he has no interest in the work, and cannot rightly claim the additional privilege guaranteed to him by the statute. In the latter case, he is bound by his agreement to transfer to another the right when it shall be secured to him".

Bowker on Copyright (1886), at page 20, states:

"An assignee cannot obtain a renewal, although an author may contract with the assignee to take out and to convey to him the benefit of a renewal; he may also contract not to renew, and so bar his own right".

and on page 34, he states:

"The relations between author and publisher are simply those between principal and agent, or, where an author sells 'outright', between buyer and seller. The 'outright' price of a book is purely a matter of bargain, and no general rule applies. The author may reserve the 'renewal' for his own benefit, or contract to renew as part of the original bargain".

4 *American and English Encyclopaedia of Law* (1888), at page 161, note 1, states:

"An assignment of an existing copyright for twenty-eight years does not include an assignment

of the renewal of the copyright for the additional term of fourteen years, unless specially expressed. *Pierpont v. Fowle*, 2 Woodb. & M. 41; *Cowen v. Banks*, 24 How. Pr. (N. Y.) 72.

"It will be different where the assignment of the manuscript has been made before any copyright was taken out. In such a case an absolute right to the renewal will vest in the assignee. *Pulte v. Derby*, 5 McLean (U. S.), 328; *Paige v. Banks*, 7 Blatchf. (U. S.) 152; 13 Wall. (U. S.) 608.

9. Cye. (1903), at page 933, states:

"as has been previously stated; the right to renew for the additional term provided by statute is in the author, his widow, or children. Whether an assignment by an author, either before or after publication, will be construed to convey his whole interest or only his interest for the first term, will depend upon the terms of the contract".

Thorvald Solberg, Register of Copyrights, was very active in the movement for revision of the copyright law which resulted in the Act of 1909. He was present at all the Committee hearings. In an address published in 1904 entitled "Copyright Protection and Statutory Formalities", at page 24, Mr. Solberg states:

"The language of the statute would seem to give to the author an inchoate right which reverts to his widow or children, should he have married and have died before the expiration of the first term of the copyright. *This contingent interest the author may undoubtedly assign; and if he is living during the six months' term when action to secure the renewal right must be taken, the author presumably is then under obligation to the assignee to take such steps to comply with the statutory formalities as will make the right good.* \* \* \* (Italics ours.)

With this array of authorities and none *contra*, the Committee must have known that under the "existing law" the contingent renewal term was assignable. We have already cited the testimony of witnesses before the Committee that the renewal term was at times sold with the original copyright. The Committee's statement that "the law should be framed as is the existing law" was utterly inconsistent with any intention to make the renewal term inalienable prior to the twenty-eighth year.

## POINT IV

**The authorities under the Act of 1909 are that there is no restriction on alienability of the renewal term.**

### 1. Text writers and cases.

The authorities declare that under the Copyright Act of 1909 an author surviving the twenty-eighth year of the original copyright is bound by his agreement to assign the renewal term made prior to the twenty-eighth year.

A year after the Copyright Act was passed, Assistant Attorney General Fowler gave an official opinion in which he discussed this question in the light of the Committee report. His opinion made it clear that the right of renewal could be contracted away by the author prior to the twenty-eighth year. The opinion reads:

"When the application for renewal is presented to the register of copyrights, the only thing left for his consideration is whether the applicant is one of the persons designated in the statute. But who may possess the legal or equitable right in the copyright after renewal is another question, and one which is to be determined by the terms of such contract as the author or other person or persons

entitled to the renewal may have entered into *before* or after the renewal is had." (28 Ops. Attys. Gen. 162, 166 (1910).) (Italics ours.)

Then after quoting from the report of the Committee, the opinion reads:

"It readily appears how the right of renewal may be a valuable asset to an author, though he may have previously parted with all interest in the copyrighted work. When renewed, like all other copyrights, it is assignable. (Sec. 42 of act; Drone on Copyrights, 3337. And no doubt it may be the subject of a valid contract *before* renewal, which would carry the equitable, if not the legal, title thereto when renewed." (id. at 169.) (Italics ours.)

The following textbooks are to the effect that the contingent renewal term may be assigned or made the subject of an agreement to assign:

Bowker—"Copyright, Its History and Its Law" (1912), pages 117, 435, 438;

Weil—"American Copyright Law" (1917), page 365 *et seq.*;

Frohlich & Schwartz—"The Law of Motion Pictures" (1918), page 549;

DeWolf—"An Outline of Copyright Law" (1925), page 66;

Marchetti—"Law of the Stage, Screen and Radio" (1936), page 67;

Wittenberg—"The Protection and Marketing of Literary Property" (1937), page 45;

2 Ladas—"International Protection of Literary and Artistic Property" (1938), page 773;

Corpus Juris Secundum (1939), vol. 18, par. 79, page 203;

Howell—"The Copyright Law" (1942), page 108.

There is a strong dictum to this effect in *Tobani v. Carl Fisher, Inc.* (C.C.A. 2d, 1938), 98 Fed. (2d) 57, 60 (cert. denied 305 U. S. 650).

Petitioners bear down hard on the language of Judge Putnam in *White-Smith Music Pub. Co. v. Goff* (C.C.A. 1st, 1911), 187 Fed. 247. In that case, a publisher agreed to pay a lump sum for each musical composition furnished by an author over a period of years, in return for "the exclusive right and title" thereto. One of the compositions was published and copyrighted in the publisher's name. Thirty-three years later, during the twenty-eighth year of the original copyright, the publisher, under Section 24 of the Act of 1909, attempted to register the renewal copyright in its name. As the opinion states (187 Fed. 247):

"Whether at this time the author was living does not appear".

The registration was refused. The defendants, making "no claim under any copyright" (*ibid.*), published the song after the expiration of the original term, and the publisher brought suit for infringement. The court held for the defendants.

With the holding of this case, we do not disagree. If the author did not survive, the publisher assignee would take nothing. Moreover, the agreement with the author did not mention the renewal term, and the lower court held (180 Fed. 256, 260) that the publisher had no rights except as proprietor of the original copyright.

The court, however, indicated that the author's renewal right could not be transferred prior to the twenty-eighth year. The court was led to this erroneous conclusion primarily because of its misinterpretation of the Act of

1831. We have demonstrated, we believe, that under that Act there was no restraint upon dealings in the renewal term.

## 2. Congressional interpretation of the Act of 1909.

Many bills introduced into Congress since the passage of the Copyright Act of 1909 indicate that the Act should be interpreted as authorizing the anticipatory assignment of the renewal term. One of such bills, S. 3047, 74th Cong., 1st Sess., passed the Senate on August 7, 1935. There were nine other bills with similar provisions,—H. R. 8557, 74th Cong., 1st Sess. (1935); H. R. 10632, 74th Cong., 2nd Sess. (1936); H. R. 5275, 75th Cong., 1st Sess. (1937); S. 2240, 75th Cong., 1st Sess. (1937); H. R. 926, 76th Cong., 1st Sess. (1939); H. R. 4871, 76th Cong., 1st Sess. (1939); H. R. 6160, 76th Cong., 1st Sess. (1939); H. R. 9703, 76th Cong., 3d Sess. (1940), and H. R. 3997, 77th Cong., 1st Sess. (1941). These bills were drafted as amendments to various sections of the Copyright Act of 1909. The bills proposed to amend Section 23 by combining the two twenty-eight year terms into a single term of fifty-six years.\* The bills also proposed to amend Section 24 by providing that the copyright subsisting in any work when the section as amended should take effect would

\* In all of these bills (except S. 3047, 74th Cong. 1st Sess.; H. R. 8557, 74th Cong., 1st Sess.) there was a specific proviso "that no assignment of the copyright and no grant of any interest therein made by the author shall be operative to vest in the assignee or grantee any rights with respect to the copyright in the work beyond the expiration of twenty-eight years from the date of copyright, and the reversionary interest in the copyright expectant at the termination of that period shall, notwithstanding any agreement to the contrary, devolve on the author of such work if living, or the widow, widower, or children of the author if the author be not living, \* \* \* and any agreement entered into by the author as to the disposition of such reversionary interest shall be null and void". This proviso, dealing with copyright which might be taken out after the effective date of the proposed amendment, shows the language Congress will use when it desires to restrict alienation of interests in copyright.

be continued until the expiration of fifty-six years from the date of the beginning of the original copyright. Then comes the provision of importance here. In all of the ten bills above mentioned, the amended Section 24 was to read as follows:

"If, on the date when this section, as amended, takes effect, *less than twenty-eight years have elapsed since the copyright began*, then the copyright for the period of such continuation beyond twenty-eight years shall vest, \* \* \* in the person or persons living on said date, \* \* \* who would have been entitled to the renewal term under this Act prior to the date when ~~this~~ section, as amended, takes effect, *subject to any agreement, valid in law or equity, which may have been made for the disposal of the renewal term prior to the date when this section, as amended, takes effect* \* \* \*".  
(~~Italic~~ ours.)

These bills, one of which passed the Senate, specifically recognized that the Copyright Act of 1909 permitted agreements disposing of the renewal term prior to the twenty-eighth year of the original term.

Another bill, H. R. 12549, 71st Cong., 2nd Sess. (1930), provided for a single term for the life of the author and fifty years. With respect to copyrights subsisting upon the effective date of the proposed bill, the term was to be extended to include the life of the author and fifty years. If with respect to such subsisting copyrights an application for renewal had not been registered under the Act of 1909, and if the author

"shall have parted with any or all of the author's rights for the first term under the Act heretofore in force, and shall have agreed to part therewith or shall have parted therewith for the renewal term under said Act, on a royalty basis" (§14)

then the assignee of such rights would be entitled to the additional period granted by the bill upon the payment of the same royalties. In the case of an outright purchase, the assignee would only get the added term if he reached an agreement with the author, or if a court fixed the conditions of such agreement. This is a clear recognition that under the Act of 1909 the author, prior to the application for the registration of the renewal of copyright, could dispose of the renewal term.

Three other bills are of like import: S. 176, 72nd Cong., 1st Sess. (1931); H. R. 6990, 71st Cong., 2nd Sess. (1929) and H. R. 10434, 69th Cong., 1st Sess. (1926).

Two other bills specifically recognize that in the case of a copyright subsisting under the Copyright Act of 1909, the author could have "agreed to renew the copyright for the renewal term for the benefit of the assignee or licensee". H. R. 10976, 72nd Cong., 1st Sess. (1932); H. R. 11948, 72nd Cong., 1st Sess. (1932).

In none of the many bills involving copyright introduced into Congress since the Act of 1909 have we been able to find any intimation that the right of renewal under that Act is at any time inalienable.

## POINT V

**During the period when the patent law provided for a renewal or extension of the patent upon the fulfillment of certain conditions, it was held that the patentee could assign the renewal or extended term while it was contingent.**

Petitioners spend much effort to prove that it is not necessary to find in a statute express words of prohibition to strike down an agreement contrary to the policy of the

statute. They cite cases arising under such laws as the National Labor Relations Act and the federal statutes regulating national banks and cases dealing with such matters as homesteads and mechanics' liens (Brief, pp. 18, 40 to 43). In these cases the agreement held void contravened a public policy created by the statute. We agree with the elementary principle on which these cases stand, but it is not applicable to the case at bar.

If analogies are desired, there is none closer to copyrights than patents. Both are monopolies created by statute by authority of the same constitutional clause. Although there has been no provision for a renewal term for patents since the Patent Act of 1872, there was a contingent renewal term granted under the 1836 Patent Act, and the question of whether or not it was assignable during the original term of the patent came before the courts. This question was determined, in the absence of specific provisions in the statute, by the ordinary rules governing assignability of contingent rights.

Under the 1836 Patent Act (5 Stat. 117), an initial term of fourteen years was granted to the patentee with the right to an extended or renewal term of seven years. The renewal term was conditioned upon proof before a statutory commission that the patentee, without fault on his part, had failed to obtain a reasonable remuneration from the patent. If the condition was fulfilled the patent would be renewed for a further term of seven years. This contingent right of renewal was held assignable.

In *Clum v. Breiver*, 5 Fed. Cases 1097 (Circuit Court, Mass., 1855), the court had before it the question of whether a deed by Samuel F. B. Morse bargaining and selling his invention in the electric telegraph transferred the right to the extended term of the patent. At the time

of the deed the patent had not been issued and of course an extension of the patent had not been issued. Judge Curtis, in construing the deed to pass the title to the extended term when issued, said:

"But the inventor has not only an inchoate right to obtain letters patent securing to him the exclusive right to his invention for the term of fourteen years, but also a further inchoate right to have the term extended, provided he shall fail, without fault, to obtain a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into public use. Though it has not been expressly determined that this last right is the subject of a contract of sale, I conceive there can be no reasonable doubt that it is so. The reasoning of the court in *Wilson v. Rousseau*, 4 How. (45 U. S.) 646, assumes and indeed asserts that it is so. And there is nothing in the nature or incidents of such a right, to distinguish it as a subject of sale, from the inchoate right to obtain the original patent. Each appertains to the inventor by reason of his invention. Each is incomplete, and its completion depends upon the compliance by the inventor with conditions, and the performance by public officers of certain acts, prescribed by law. It is true, the title of an inventor to an extension is still further qualified by a further condition, of his failure to obtain remuneration from the enjoyment of the exclusive right for the first term of fourteen years. But though this is an additional condition, which may render parties less willing to contract, its existence does not change the nature of the right, and it no more prevents it from being the subject of a contract of sale, than any other condition which is attached to it." (5 Fed. Cas. 1102.)

The same doctrine was applied in *Nicholson Pavement Co. v. Jenkins*, 14 Wall. 452, and *Heudrie v. Sayles*, 8 Otto (98 U. S.) 546. In the latter case an assignment covered the inventor's right, title and interest "in and to said invention and patent and any extension thereof that may hereafter be granted." (8 Otto (98 U. S.) 549-550). Thereafter application was made for a renewal and extension of the patent and the application was granted. The controversy between the parties was whether the assignment passed title to the extended term of the patent. The court reviewed the authorities including *Clum v. Brewer*, *supra*; it also relied on *Carman v. Bowles*, *supra*, which dealt with assignments of contingent renewals of copyright. The court said:

"it is equally clear that they may sell, assign or convey the invention, including the inchoate right to obtain the patent, and to surrender and re-issue it or to procure a renewal or extension of the monopoly from the Commissioner; if the instrument of assignment contains apt words to show that such was the intent of the grantor." (p. 551)

The dissenting opinion below in the case at bar attempts to throw off the effect of these authorities by intimating that the Patent Act of 1836 made express provision for the assignment of the contingent renewal term (R. 119), quoting from the Act as follows:

"And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein . . . ."

But this provision refers only to "assignees and grantees of the right to use the thing patented," and in

*Wilson v. Rousseau*, 4 How. (45 U. S.) 646, was specifically held not to refer to assignees and grantees of the renewal.

## POINT VI

The practical considerations are against the interpretation that there are restrictions on the alienability of the renewal term.

### 1. The problem of determining when the restrictions cease.

Although Petitioners strike broadly at all attempts by the author to make anticipatory assignments of his renewal term, they, of course, admit that the renewal term after it has vested can be assigned. But nowhere in their brief do they make it clear just when the right to assign attaches. Can the author assign at any time after the twenty-eighth year has begun? Can he assign only after "application \* \* \* shall have been made to the copyright office"? Can he assign only after such application has been "duly registered"? If Petitioners' theory should be upheld, there will still remain much uncertainty, unless it is determined when the restrictions on alienation cease.

### 2. Advantages to the author and his family from the right to deal in the contingent renewal term.

Petitioners argue that because the author's right in the renewal term prior to the twenty-eighth year is contingent on his survivorship, its value is necessarily speculative, and the statute intended to forbid all dealings in the contingent right in order to protect the author.

Petitioners thus say that since in this respect authors have little, that little which they have they may not dispose of. The Copyright Act has no general policy against dealing in works on a speculative basis. No one can fix the value of a book or song before it is written, yet it is clear that an author is held to a bargain transferring the rights in a work which he has yet to create. *Harms, et al. v. Stern* (C.C.A. 2d, 1916), 231 Fed. 645.

The speculative element surrounding transactions involving renewal rights has not prevented purchasers from paying substantial sums for them. The author, his wife and children were paid for their contingent renewal rights in *Selwyn & Co., Inc. v. Veiller* (S.D.N.Y., 1942), 43 F. Supp. 491. In another case, the author's wife received five thousand dollars for her contingent rights, even though, as events turned out, she predeceased her husband. *Tobani v. Fischer, Inc.*, 263 App. Div. 503 (2nd Dept., 1942), *aff'd*, N. Y. Court of Appeals, Dec. 3, 1942. The present practice of Respondent, when a songwriter is in need of money, is to make advances against royalties to accrue and to take an assignment of the contingent renewal copyright as security for the advance (R. 58). In these transactions the author or his wife is passing to the purchaser the risk of survivorship. If the author is forbidden to deal in the contingent renewal term, then the risk must remain with the author because if he does not survive, he takes nothing.

Many transactions involving the contingent renewal term, such as the 1910 agreement in the case at bar, eliminate this speculative element. There is no more speculation in a royalty agreement covering the original and renewal term than there is in one covering the original term alone, except that fifty-six years are involved and not twenty-eight.

### **3. Difficulty in marketing the work toward the end of the original term.**

If renewal rights are made unassignable prior to the twenty-eighth year, then, as the original term approaches expiration, only the few remaining years of that term can be disposed of or licensed. For instance, near the end of the original term a motion picture producer could not afford to buy a license to make a motion picture of a story because the limited term which he could acquire would not justify the investment necessary for the production of the picture. It is true that even on our interpretation the acquisition of the renewal term involves the risk of the author's survivorship, but there is always such risk in purchasing property in which there are contingent estates. Our interpretation tends towards the preservation of the right to deal in copyrighted works, and unlike Petitioners' contention, does not take such property off the market toward the end of the original term.

### **4. Upsetting transactions entered into in good faith.**

The renewal term has been considered assignable after, as well as before, the passage of the 1909 Act, and, unquestionably, many transactions have taken place on this basis. See for example forms of contract covering book publishing rights and motion picture rights in Wittenberg, "The Protection and Marketing of Literary Property", 195, 261 (1937). If Petitioners are successful, many now exercising in good faith rights in a renewal term would become copyright infringers retroactively since the renewal term began.

### 5. The problem of licenses.

Many, if not most, transactions under the Copyright Act take the form of licenses rather than assignments. Suppose the author for a consideration agrees, prior to the last year of the original term, to grant a license under the renewal term. If the author survives, of course he would be entitled to the renewal term, and the application for it would be made in his name. Even under Petitioners' interpretation there is no language in the Act which is not completely complied with. But Petitioners cannot admit the validity of the agreement to license, or of an agreement to take out the renewal and assign it, because the admission would destroy the broad policy which Petitioners seek to find in the Act.

### CONCLUSION

**The order of the Circuit Court of Appeals affirming the order of the District Court granting a preliminary injunction should be affirmed in so far as it is based on the holding that the Copyright Act does not invalidate an assignment of the renewal term made prior to the twenty-eighth year of the original term.**

Respectfully submitted,

ROBERT W. PERKINS,  
*Solicitor for Respondent.*

STUART H. AARONS,  
SIDNEY BARROWS,  
*of Counsel.*

## APPENDIX

## Act of 8 Anne c. 19 (1709)

WHEREAS, *Printers, booksellers, and other persons have of late frequently taken the liberty of printing, reprinting, and publishing, or causing to be printed, reprinted, and published, books and other writings, without the consent of the authors or proprietors of such books and writings, to their very great detriment, and too often to the ruin of them and their families: for preventing therefore such practices for the future, and for the encouragement of learned men to compose and write useful books; may it please your Majesty, that it may be enacted, and be it enacted by the Queen's most Excellent majesty, by and with the advice and consent of the lords spiritual and temporal, and commons, in this present parliament assembled, and by the authority of the same, That from and after the tenth day of April, one thousand seven hundred and ten, the author of any book or books already printed, who hath not transferred to any other the copy or copies of such book or books, share or shares thereof, or the bookseller or booksellers, printer or printers, or other person or persons, who hath or have purchased or acquired the copy or copies of any book or books, in order to print or reprint the same, shall have the sole right and liberty of printing such book and books for the term of one and twenty years, to commence from the said tenth day of April, and no longer; and that the author of any book or books already composed, and not printed and published, or that shall hereafter be composed, and his assignee or assigns, shall have the sole liberty of printing and reprinting such book and books for the term of fourteen years, to commence from the day of the first publishing the same, and no longer;*

. . . . .

XI. Provided always, that after the expiration of the said term of fourteen years, the sole right of printing or

disposing of copies shall return to the authors thereof, if they are then living, for another term of fourteen years.

### **Resolution of May 2, 1783 of the Continental Congress**

*Resolved*, That it be recommended to the several states, to secure to the authors or publishers of any new books not hitherto printed, being citizens of the United States, and to their executors, administrators and assigns, the copyright of such books for a certain time not less than fourteen years from the first publication; and to secure to the said authors, if they shall survive the term first mentioned, and to their executors, administrators and assigns, the copyright of such books for another term of time not less than fourteen years, such copy or exclusive right of printing, publishing and vending the same, to be secured to the original authors, or publishers, their executors, administrators and assigns, by such laws and under restrictions to the several states may seem proper. (Journal of Congress, May 2, 1783.)

### **Act of May 31, 1790**

Section 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That from and after the passing of this act, the author and authors of any map, chart, book or books already printed within these United States, being a citizen or citizens thereof, or resident within the same, his or their executors, administrators or assigns, who hath or have not transferred to any other person the copyright of such map, chart, book or books, share or shares thereof; and any other person or persons, being a citizen or citizens of these United States, or residents therein, his or their executors, administrators or assigns, who hath or have purchased or legally acquired the copyright of any such map, chart, book or books, in order to print, reprint, publish or vend the same, shall have the sole right and liberty of printing, reprinting, publishing and vending such map, chart, book or books, for the term of fourteen

years from the recording the title thereof in the clerk's office, as herein after directed: And that the author and authors of any map, chart, book or books already made and composed and not printed or published, or that shall hereafter be made and composed, being a citizen or citizens of these United States, or resident therein, and his or their executors, administrators or assigns; shall have the sole right and liberty of printing, reprinting, publishing and vending such map, chart, book or books, for the like term of fourteen years from the time of recording the title thereof in the clerk's office as aforesaid. And if, at the expiration of the said term, the author or authors, or any of them, ~~be living,~~ and a citizen or citizens of these United States, or resident therein, the same exclusive right shall be continued to him or them, his or their executors, administrators or assigns, for the further term of fourteen years: *Provided*, he or they shall cause the title thereof to be a second time recorded and published in the same manner as is herein after directed, and that within six months before the expiration of the first term of fourteen years aforesaid.

Sec. 3. *And be it further enacted*, That no person shall be entitled to the benefit of this act, in cases where any map, chart, book or books, hath or have been already printed and published, unless he shall first deposit, and in all other cases, unless he shall before publication deposit a printed copy of the title of such map, chart, book or books, in the clerk's office of the district court where the author or proprietor shall reside; \* \* \* And such author or proprietor shall, within two months from the date thereof, cause a copy of the said record to be published in one or more of the newspapers printed in the United States, for the space of four weeks. (1 Stat. 124 (1790)§)

### Act of February 3, 1831

*Be it enacted by the Senate and House of Representatives of the United States of America, in Congress assembled*, That from and after the passing of this act, any

person or persons, being a citizen or citizens of the United States, or resident therein, who shall be the author or authors of any book or books, map, chart, or musical composition, which may be now made or composed, and not printed and published, or shall hereafter be made or composed, or who shall invent, design, etch, engrave, work, or cause to be engraved, etched, or worked from his own design, any print or engraving, and the executors, administrators, or legal assigns of such person or persons, shall have the sole right and liberty of printing, reprinting, publishing, and vending such book or books, map, chart, musical composition, print, cut, or engraving, in whole or in part, for the term of twenty-eight years from the time of recording the title thereof, in the manner hereinafter directed.

Sec. 2. *And be it further enacted*, That if, at the expiration of the aforesaid term of years, such author, inventor, designer, engraver, or any of them, where the work had been originally composed and made by more than one person, be still living, and a citizen or citizens of the United States, or resident therein, or being dead, shall have left a widow, or child, or children, either or all then living, the same exclusive right shall be continued to such author, designer, or engraver, or, if dead, then to such widow and child, or children, for the further term of fourteen years: *Provided*, That the title of the work so secured shall be a second time recorded, and all such other regulations as are herein required in regard to original copyrights, be complied with in respect to such renewed copyright, and that within six months before the expiration of the first term.

• Sec. 3. *And be it further enacted*, That in all cases of renewal of copyright under this act, such author or proprietor shall, within two months from the date of said renewal, cause a copy of the record thereof to be published in one or more of the newspapers printed in the United States, for the space of four weeks.

Sec. 4. *And be it further enacted*, That no person shall be entitled to the benefit of this act, unless he shall, before publication, deposit a printed copy of the title of such book, or books, map, chart, musical composition, print, cut, or engraving, in the clerk's office of the district court of the district wherein the author or proprietor shall reside, \* \* \* And the author or proprietor of any such book, map, chart, musical composition, print, cut, or engraving, shall, within three months from the publication of said book, map, chart, musical composition, print, cut, or engraving, deliver or cause to be delivered a copy of the same to the clerk of said district. \* \* \*

Sec. 5. *And be it further enacted*, That no person shall be entitled to the benefit of this act, unless he shall give information of copyright being secured, by causing to be inserted, in the several copies of each and every edition published during the term secured on the title-page, or the page immediately following, if it be a book, or, if a map, chart, musical composition, print, cut, or engraving, by causing to be impressed on the face thereof, or if a volume of maps, charts, music, or engravings, upon the title or frontispiece thereof, the following words, viz: "Entered according to act of Congress, in the year , by A.B., in the clerk's office of the district court of , " (as the case may be.)

\* \* \*

Sec. 16. *And be it further enacted*, That, whenever a copyright has been heretofore obtained by an author or authors, inventor, designer, or engraver, of any book, map, chart, print, cut, or engraving, or by a proprietor of the same: if such author or authors, or either of them, such inventor, designer, or engraver, be living at the passage of this act, then such author or authors, or the survivor of them, such inventor, engraver, or designer, shall continue to have the same exclusive right to his book, chart, map, print, cut, or engraving, with the benefit of each and all the provisions of this act, for the security

thereof, for such additional period of time as will, together with the time which shall have elapsed from the first entry of such copyright, make up the term of twenty-eight years, with the same right to his widow, child, or children, to renew the copyright, at the expiration thereof, as is above provided in relation to copyrights originally secured under this act. And if such author or authors, inventor, designer, or engraver, shall not be living at the passage of this act, then, his or their heirs, executors and administrators, shall be entitled to the like exclusive enjoyment of said copyright, with the benefit of each and all the provisions of this act for the security thereof, for the period of twenty-eight years from the first entry of said copyright; with the like privilege of renewal to the widow, child, or children, of author or authors, designer, inventor, or engraver, as is provided in relation to copyrights originally secured under this act; *Provided*, That this act shall not extend to any copyright heretofore secured, the term of which has already expired. (4 Stat. 436 (1831).)

#### Act of July 8, 1870

SEC. 86. *And be it further enacted*, That any citizen of the United States, or resident therein, who shall be the author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print, or photograph or negative thereof, or of a painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts, and his executors, administrators, or assigns, shall, upon complying with the provisions of this act, have the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing, and vending the same; and in the case of a dramatic composition, of publicly performing or representing it, or causing it to be performed or represented by others; and authors may reserve the right to dramatize or to translate their own works. (16 Stat. 212.)

SEC. 87. *And be it further enacted*, That copyrights shall be granted for the term of twenty-eight years from

the time of recording the title thereof, in the manner hereinafter directed.

SEC. 88. *And be it further enacted*, That the author, inventor, or designer, if he be still living and a citizen of the United States or resident therein, or his widow or children, if he be dead, shall have the same exclusive right continued for the further term of fourteen years, upon recording the title of the work or description of the article so secured a second time, and complying with all other regulations in regard to original copyrights, within six months before the expiration of the first term. And such person shall, within two months from the date of said renewal, cause a copy of the record thereof to be published in one or more newspapers, printed in the United States, for the space of four weeks.

SEC. 89. *And be it further enacted*, That copyrights shall be assignable in law, by any instrument of writing, and such assignment shall be recorded in the office of the librarian of Congress within sixty days after its execution, in default of which it shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice.

#### **Relevant Sections of the Copyright Act of 1909 As Amended**

§8. That the author or proprietor of any work made the subject of copyright by this Act, or his executors, administrators, or assigns, shall have copyright for such work under the conditions and for the terms specified in this Act . . . (35 Stat. 1077.)

§23. That the copyright secured by this Act shall endure for twenty-eight years from the date of first publication, whether the copyrighted work bears the author's true name or is published anonymously or under an assumed name: *Provided*, That in the case of any posthumous work or of any ~~periodical~~ encyclopedic, or other composite work upon which the copyright was originally secured by the

proprietor thereof, or of any work copyrighted by a corporate body (otherwise than as assignee or licensee of the individual author) or by an employer for whom such work is made for hire, the proprietor of such copyright shall be entitled to a renewal and extension of the copyright in such work for the further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright; *And provided further*, That in the case of any other copyrighted work, including a contribution by an individual author to a periodical or to a cyclopedic or other composite work, the author of such work, if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then the author's executors, or in the absence of a will, his next of kin shall be entitled to a renewal and extension of the copyright in such work for a further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright; *And provided further*, That in default of the registration of such application for renewal and extension, the copyright in any work shall determine at the expiration of twenty-eight years from first publication. (54 Stat. 51.)

§41. That the copyright is distinct from the property in the material object copyrighted, and the sale or conveyance, by gift or otherwise, of the material object shall not of itself constitute a transfer of the copyright, nor shall the assignment of the copyright constitute a transfer of the title to the material object; but nothing in this Act shall be deemed to forbid, prevent, or restrict the transfer of any copy of a copyrighted work the possession of which has been lawfully obtained. (35 Stat. 1084.)

§42. That copyright secured under this or previous Acts of the United States may be assigned, granted, or mortgaged by an instrument in writing signed by the proprietor of the copyright, or may be bequeathed by will. (35 Stat. 1084.)

§43. That every assignment of copyright executed in a foreign country shall be acknowledged by the assignor before a consular officer or secretary of legation of the United States authorized by law to administer oaths or perform notarial acts. The certificate of such acknowledgment under the hand and official seal of such consular officer or secretary of legation shall be prima facie evidence of the execution of the instrument. (35 Stat. 1084.)

§44. That every assignment of copyright shall be recorded in the copyright office within three calendar months after its execution in the United States or within six calendar months after its execution without the limits of the United States, in default of which it shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, whose assignment has been duly recorded. (35 Stat. 1084.)

§45. That the register of copyrights shall, upon payment of the prescribed fee, record such assignment, and shall return it to the sender with a certificate of record attached under seal of the copyright office, and upon the payment of the fee prescribed by this Act he shall furnish to any person requesting the same a certified copy thereof under the said seal. (35 Stat. 1085.)

§46. That when an assignment of the copyright in a specified book or other work has been recorded the assignee may substitute his name for that of the assignor in the statutory notice of copyright prescribed by this Act. (35 Stat. 1085.)



# SUPREME COURT OF THE UNITED STATES.

No. 327.—OCTOBER TERM, 1942.

Fred Fisher Music Co., Inc., and George Graff, Jr., Petitioners. vs. M. Witmark & Sons.	} On Writ of Certiorari to the United States Circuit Court of Appeals for the Second Circuit.
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[April 5, 1943.]

Mr. Justice FRANKFURTER delivered the opinion of the Court.

This case presents a question never settled before, even though it concerns legislation having a history of more than two hundred years. The question itself can be stated very simply. Under § 23 of the Copyright Act of 1909, 35 Stat. 1075, as amended,<sup>1</sup> a copyright in a musical composition lasts for twenty-eight years from the date of its first publication, and the author can renew the copyright, if he is still living, for a further term of twenty-eight years by filing an application for renewal within a year

<sup>1</sup> The relevant provisions of the Copyright Act read as follows:

SEC. 23. That the copyright secured by this Act shall endure for twenty-eight years from the date of first publication, whether the copyrighted work bears the author's true name or is published anonymously or under an assumed name: *Provided*, That in the case of any posthumous work or of any periodical, cyclopaedic, or other composite work upon which the copyright was originally secured by the proprietor thereof, or of any work copyrighted by a corporate body (otherwise than as assignee or licensee of the individual author) or by an employer for whom such work is made, for hire, the proprietor of such copyright shall be entitled to a renewal and extension of the copyright in such work for the further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright: *And provided further*, That in the case of any copyrighted work, including a contribution by an individual author to a periodical or to a cyclopaedic or other composite work, the author of such work, if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then the author's executors, or in the absence of a will, his next of kin shall be entitled to a renewal and extension of the copyright in such work for a further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright: *And provided further*, That in default of the registration of such application for renewal and extension, the copyright in any work shall determine at the expiration of twenty-eight years from first publication.

SEC. 42. That copyright secured under this or previous Acts of the United States may be assigned, granted, or mortgaged by an instrument in writing signed by the proprietor of the copyright, or may be bequeathed by will.

before the expiration of the first twenty-eight year period. Section 42 of the Act provides that a copyright "may be assigned by an instrument in writing signed by the proprietor of the copyright." Concededly, the author can assign the original copyright and, after he has secured it, the renewal copyright as well. The question is—does the Act prevent the author from assigning his interest in the renewal copyright before he has secured it?

This litigation arises from a controversy over the renewal rights in the popular song "When Irish Eyes Are Smiling". It was written in 1912 by Ernest R. Ball, Chauncey Olcott, and George Graff, Jr., each of whom was under contract to a firm of music publishers, M. Witmark & Sons. Pursuant to the contracts Witmark on August 12, 1912, applied for and obtained the copyright in the song. On May 19, 1917, Graff and Witmark made a further agreement under which, for the sum of \$1600, Graff assigned to Witmark "all rights, title and interest" in a number of songs, including "When Irish Eyes Are Smiling". The contract provided for the conveyance of "all copyrights and renewals of copyrights and the right to secure all copyrights and renewals of copyrights in the [songs], and any and all rights therein that I [Graff], or my heirs, executors, administrators or next of kin may at any time be entitled to". To that end Witmark was given an irrevocable power of attorney to execute in Graff's name all documents "necessary to secure to [Witmark] the renewals and extensions of the copyrights in said compositions and all rights therein for the terms of such renewals and extensions". In addition, Graff agreed that, "upon the expiration of the first term of any copyright", he would execute and deliver to Witmark "all papers necessary in order to secure to it the renewals and extensions of all copyrights in said compositions and all rights therein for the terms of such renewals and extensions". This agreement was duly recorded in the Copyright Office.

On August 12, 1939, the first day of the twenty-eighth year of the copyright in "When Irish Eyes Are Smiling", Witmark applied for and registered the renewal copyright in Graff's name.<sup>2</sup>

<sup>2</sup> Ball and Olcott were no longer living at the time, and under § 23 of the Act their interests in the renewal passed to their widows. Witmark is also the assignee of Mrs. Olcott's interest in the renewal copyright, and Mrs. Ball has assigned her interest to another music publisher. The validity of neither assignment is involved in this suit.

On the same day, exercising its power of attorney under the agreement of May 19, 1917, Witmark also assigned to itself Graff's interest in the renewal. Eleven days later Graff himself applied for and registered the renewal copyright in his own name, and on October 24, 1939, he assigned his renewal interest to another music publishing firm, Fred Fisher Music Co., Inc. Both Graff and Fisher knew of the prior registration of the renewal by Witmark and of the latter's assignment to itself. Relying upon the validity of the assignment made to it on October 24, 1939, and without obtaining permission from Witmark, Fisher published and sold copies of "When Irish Eyes Are Smiling", representing to the trade that it owned the renewal rights in the song. Witmark thereupon brought this suit to enjoin these activities. The District Court granted a preliminary injunction *pendente lite* solely upon the ground that there was no statutory bar against an author's assignment of his interest in the renewal before it was secured. The court considered no evidence and made no findings upon the question whether equitable relief should be denied on other grounds, such as inadequacy of consideration and the like.<sup>3</sup> Upon appeal to the Circuit Court of Appeals for the Second Circuit under § 129 of the Judicial Code, 28 U. S. C. § 227, permitting appeals from interlocutory decrees, the order was affirmed. 125 F. 2d 949. The Circuit Court of Appeals limited itself, as did the parties before it, to the question of statutory construction, wholly apart from the particular circumstances of the case. The court expressly left open "other contentions which the parties may wish and be entitled to raise on the merits, including possibly claims of inadequacy of consideration". 125 F. 2d at 954. The petition for certiorari in this Court stated that the "sole question is whether . . . an agreement to assign his renewal, made by an author in advance of the twenty-eighth year of the original term of copyright, is valid and enforceable". Because of the obvious importance of this question of the proper construction of the Copyright Act, we brought the case here. 317 U. S. —

Plainly, there is only one question before us—does the Copyright Act nullify an agreement by an author, made during the original copyright term, to assign his renewal? The explicit words of the

<sup>3</sup> In opposing the motion for a preliminary injunction Graff submitted an affidavit stating he "was in desperate financial straits" when he entered into the agreement of May 19, 1917. The district court made no findings upon and did not otherwise deal with the issue that this allegation may raise.

statute give the author an unqualified right to renew the copyright. No limitations are placed upon the assignability of his interest in the renewal. If we look only to what the Act says, there can be no doubt as to the answer. But each of the parties finds support for its conclusion in the historical background of copyright legislation, and to that we must turn to discover whether Congress meant more than it said.

Anglo-American copyright legislation begins in 1709 with the Statute of 8 Anne, c. 19. That act gave the author and his assigns the exclusive copyright for fourteen years from publication, and after the expiration of such term, if the author was still living, the copyright could be renewed for another fourteen years. The statute did not expressly provide that the author could assign his renewal interest during the original copyright term. But the English courts held that the author's right of renewal, although contingent upon his surviving the original fourteen-year period, could be assigned, and that if he did survive the original term he was bound by the assignment. *Carnan v. Bowles*, 2 Bro. C. C. 80; *Rundell v. Murray*, Jac. 311; see Maugham, *Law of Literary Property* (1828) 73; Curtis on Copyright (1847) 235. Subsequent English legislation eliminated the problem by providing for one continuous term of copyright. In 1814 the statute was amended to provide that the author and his assigns should have the copyright for twenty-eight years, "and also, if the author shall be living at the end of that period, for the residue of his natural life". 54 Geo. III, c. 156. In 1842 the copyright term was extended to forty-two years or the life of the author and seven years, whichever should prove longer. 5 & 6 Vict., c. 45; see Macgillivray, *Law of Copyright* (1902) 56-57. The English law today, with minor qualifications not relevant here, gives the author and his assigns the exclusive copyright for the life of the author and fifty years after his death. Copyright Act of 1911, 1 & 2 Geo. V, c. 34; see Oldfield, *Law of Copyright* (1912) 60-66; Robertson, *Law of Copyright* (1912) 44-50; Copinger, *Law of Copyright* (7th ed. 1936) 78-86.

In this country the copyright laws enacted by the original thirteen states prior to 1789 were based largely upon the Statute of Anne. In 1783 the Continental Congress passed a resolution calling upon the states to adopt copyright legislation for the protection of authors and publishers. The resolution recommended that copyright be given to authors and publishers "for a certain time, not

less than fourteen years from the first publication; and to secure to the said authors, if they shall survive the term first mentioned, and to their executors, administrators and assigns, the copyright of such books for another term of time not less than fourteen years". *Journals of the Continental Congress, 1774-1789* (1922), vol. xxiv, pp. 326-27. When the resolution was adopted, laws governing copyrights were on the statute-books of at least three states, Connecticut, Massachusetts, and Maryland. The Connecticut and Maryland statutes substantially followed the Statute of Anne: in both states copyright was granted for a term of fourteen years, renewable for another term of the same length if the author survived the original term. Connecticut, *Acts & Laws* (Green, 1783) 617-19; Maryland, *Laws* (Green, 1783) c. 34. The Maryland statute employed the phraseology of the Statute of Anne, providing simply that the privilege of renewal belonged to the author. The Connecticut statute, however, explicitly incorporated the construction made by the English courts, and conferred the right of renewal upon the author and "his heirs and assigns". The Massachusetts statute created a single copyright term of twenty-one years. *Massachusetts, Acts & Laws* (Edes, 1783) 236.

In response to the resolution of the Congress, nine of the ~~ten~~ other states enacted copyright legislation. Only Delaware did not adopt a copyright statute. Five states accepted the recommendation of the Congress and followed the Statute of Anne: two copyright terms of fourteen years, the second term contingent upon the author's surviving the first. New Jersey, *Acts of the General Assembly* (Collins, 1783) c. 21; Pennsylvania, *Laws* (Bradford, 1784) c. 125; South Carolina, *Acts, Ordinances and Resolves* (Miller, 1784) 49-51; Candler, *Colonial Records of Georgia* (1911), vol. xix, part 2, pp. 485-89; *Laws of New York*, 1786, c. 54. Four of these, like the earlier Connecticut statute, explicitly provided that the right of renewal could be exercised by the author's heirs and assigns, namely, New Jersey, Pennsylvania, Georgia, and New York. The four remaining states enacted statutes providing for single terms of varying lengths, ranging from fourteen to twenty-one years. New Hampshire, *Laws* (Mekher, 1789) 161-62; Rhode Island, *Acts and Resolves* (Carter, 1783) 6-7; Virginia, *Acts* (Dunlap & Hayes, 1785) 8-9; North Carolina, *Laws* 1785, c. 24.

Exercising the power granted by Article 1, § 8 of the Constitution—"To promote the Progress of Science and useful Arts, by

securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries"—the first Congress enacted a copyright statute, the Act of May 31, 1790, 1 Stat. 124. As might have been expected, this Act reflected its historical antecedents. The author was given the copyright for fourteen years and "if, at the expiration of the said term, the author or authors, or any of them, be living, and a citizen or citizens of these United States, or resident therein, the same exclusive right shall be continued to him or them, his or their executors, administrators or assigns, for the further term of fourteen years". 1 Stat. 124. In view of the language and history of this provision, there can be no doubt that if the present case had arisen under the Act of 1790, there would be no statutory restriction upon the assignability of the author's renewal interest. The petitioners contend, however, that such a limitation was introduced by subsequent legislation, particularly the Copyright Acts of 1831 and 1909.

The Act of February 3, 1831, 4 Stat. 436, amended the 1790 Act in two important respects: the original term was increased from fourteen to twenty-eight years, and the renewal term, although still only fourteen years long, could pass to the author's widow or children if he did not survive the original term. The renewal provision, like the Statute of Anne, did not refer to the author's "assigns". The purpose of these changes, as stated in the report of the Committee on the Judiciary of the House of Representatives was "chiefly to enlarge the period for the enjoyment of copy-right, and thereby to place authors in this country more nearly upon an equality with authors in other countries.

In the United States, by the existing laws, a copy-right is secured to the author, in the first instance, for fourteen years; and if, at the end of that period, he be living, then for fourteen years more; but, if he be not then living, the copy-right is determined, although, by the very event of the death of the author, his family stand in more need of the only means of subsistence ordinarily left to them." Register of Debates, vol. 7, appendix. CXIX.

Plainly, therefore, the Copyright Act of 1831 merely enlarged the benefits of the copyright; it extended the length of the original term and gave the author's widow and children that which theretofore they did not possess, namely, the right of renewal to

which the author would have been entitled if he had survived the original term. The petitioners attach much significance to a sentence appearing in the report of the committee: "The question is, whether the author or the bookseller should receive the reward." *Ibid.* The meaning of this sentence, read in its context, is quite clear. By providing that, if the author should not survive the original term, his renewal interest should, instead of falling into the public domain, pass to his widow and children, Congress was of course preferring the author to the bookseller. But neither expressly nor impliedly did the Act of 1831 impose any restraints upon the right of the author himself to assign his contingent interest in the renewal. That the Act contained no such limitation was accepted without question both by the courts, see *Pierpont v. Fowle*, 19 Fed. Cas. 652 (C. C. Mass. 1846), and *Paige v. Banks*, 13 Wall. 608, with which compare *White-Smith Music Pub. Co. v. Goff*, 187 Fed. 247, 250-53, and by commentators, see Curtis on Copyright (1847) 235; 2 Morgan, Law of Literature (1875) 229-30; Spalding, Law of Copyright (1878) 111; Drone on Copyright (1879) 326-32; Bowker on Copyright (1886) 20, 34; 2 Kent's Commentaries (12th ed. 1873) 510; Solberg, Copyright Protection and Statutory Formalities (1904) 24. Representative Ellsworth,<sup>4</sup> who submitted the committee report on the bill that became the Copyright Act of 1831, himself stated unequivocally that an agreement to assign the renewal was binding upon the author. See Ellsworth, Copy-Right Manual (1862) 29.

We come, finally, to the Copyright Act of March 4, 1909, 35 Stat. 1075, which, except for some minor amendments not relevant here, is the statute in effect at the present time. In December, 1905, President Theodore Roosevelt urged the Congress to undertake a revision of the copyright laws. H. Doc. 1, 58th Cong., 1st Sess., p. LI. In response to this message the Librarian of Congress, under whose authority the Copyright Office functions, invited persons interested in copyright legislation to attend a conference for the purpose of devising a satisfactory measure. Several conferences were held in 1905 and 1906, resulting in a bill which was introduced in the House and Senate by the chairman of the Committee on Patents in each body. This bill (H. R. 19853 and S. 6330, 59th Cong., 1st Sess.) provided, in the case of books and musical compositions, for

<sup>4</sup> William Wolcott Ellsworth, the son of Oliver Ellsworth, third Chief Justice of the United States. See Biographical Directory of the American Congress, 1774-1927 (1928) 943.

a single copyright term lasting for the life of the author and for fifty years thereafter. Joint hearings by the House and Senate Committees were held on this bill, but no action was taken by the Fifty-ninth Congress. At the next session of Congress this and other bills to revise the copyright laws were again introduced. Extensive public hearings were held. The result of this elaborate legislative consideration of the problem of copyright was a bill (H. R. 28192; S. 9440) which became the Copyright Act of 1909. As stated in the report of the House committee, this bill "differs in many respects from any of the bills previously introduced. Your committee believes that in all its essential features it fairly meets and solves the difficult problems with which the committee had to deal."

H. Rep. 2222, 60th Cong., 2d Sess., p. 4. Under the bill copyright was given for twenty-eight years, with a renewal period of the same duration. The report of the House committee indicates the reasons for this provision. This section of the report, to which much importance has been attached by the judges of the court below and by the parties, must be read in the light of the specific problem with which the Congress was presented: should there be one long term, as was provided for in the bill resulting from the conferences held by the Librarian of Congress, or should there be two shorter terms? The House and Senate committees chose the latter alternative. They were aware that an assignment by the author of his "copyright" in general terms did not include conveyance of his renewal interest. See *Pierpont v. Fowle*, 19 Fed. Cas. 652 (C. C. Mass. 1846); 2 Morgan, *Law of Literature* (1875) 229-30; Macgillivray, *Law of Copyright* (1902) 267. During the hearings of the Joint Committee, Representative Currier, the chairman of the House committee, referred to the difficulties encountered by Mark Twain:

"Mr. Clemens told me that he sold the copyright for *Innocents Abroad* for a very small sum, and he got very little out of the *Innocents Abroad* until the twenty-eight year period expired, and then his contract did not cover the renewal period, and in the fourteen years of the renewal period he was able to get out of it all of the profits." (Hearings before the Committees on Patents of the Senate and House of Representatives on Pending Bills to Amend and Consolidate the Acts respecting Copyright, 60th Cong., 1st Sess., p. 20.)

By providing for two copyright terms, each of relatively short duration, Congress enabled the author to sell his "copyright"

without losing his renewal interest. If the author's copyright extended over a single, longer term, his sale of the "copyright" would terminate his entire interest. That this is the basic consideration of policy underlying the renewal provision of the Copyright Act of 1909 clearly appears from the report of the House committee which submitted the legislation (the Senate committee adopted the report of the House committee, see Sen. Rep. 1108, 60th Cong., 2d Sess.):

"Section 23 deals with the term of the copyright. Under existing law the copyright term is twenty-eight years, with the right of renewal by the author, or by the author's widow or children if he be dead, for a further term of fourteen years. The act of 1790 provided for an original term of fourteen years, with the right of renewal for fourteen years. The act of 1831 extended the term to its present length. It was urged before the committee that it would be better to have a single term without any right of renewal, and a term of life and fifty years was suggested. Your committee, after full consideration, decided that it was distinctly to the advantage of the author to preserve the renewal period. It not infrequently happens that the author sells his copyright outright to a publisher for a comparatively small sum. If the work proves to be a great success and lives beyond the term of twenty-eight years, your committee felt that it should be the exclusive right of the author to take the renewal term, and the law should be framed as is the existing law [*italics ours*], so that he could not be deprived of that right.

"The present term of twenty-eight years, with the right of renewal for fourteen years, in many cases is insufficient. The terms, taken together, ought to be long enough to give the author the exclusive right to his work for such a period that there would be no probability of its being taken away from him in his old age, when, perhaps, he needs it the most. A very small percentage of the copyrights are ever renewed. All use of them ceases in most cases long before the expiration of twenty-eight years. In the comparatively few cases where the work survives the original term the author ought to be given an adequate renewal term. In the exceptional case of a brilliant work of literature, art, or musical composition it continues to have a value for a long period, but this value is dependent upon the merit of the composition. Just in proportion as the composition is meritorious and deserving will it continue to be profitable, provided the copyright is extended so long; and it is believed that in all such cases where the merit is very high this term is certainly not too long.

"Your committee do not favor and the bill does not provide for any extension of the original term of twenty-eight years, but it does provide for an extension of the renewal term from fourteen

years to twenty-eight years; and it makes some change in existing law as to those who may apply for the renewal. Instead of confining the right of renewal to the author, if still living, or to the widow or children of the author, if he be dead, we provide that the author of such work, if still living, may apply for the renewal, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then the author's executors, or, in the absence of a will, his next of kin. It was not the intention to permit the administrator to apply for the renewal, but to permit the author who had no wife or children to bequeath by will the right to apply for the renewal." (H. Rep. 2222, 60th Cong., 2d Sess., pp. 14-15.)

The report cannot be tortured, by reading it without regard to the circumstances in which it was written, into an expression of a legislative purpose to nullify agreements by authors to assign their renewal interests. If Congress, speaking through its responsible members, had any intention of altering what theretofore had not been questioned, namely, that there were no statutory restraints upon the assignment by authors of their renewal rights, it is almost certain that such purpose would have been manifested. The legislative materials reveal no such intention.

We agree with the court below, therefore, that neither the language nor the history of the Copyright Act of 1909 lend support to the conclusion that the "existing law" prior to 1909, under which authors were free to assign their renewal interests if they were so disposed, was intended to be altered. We agree, also, that there are no compelling considerations of policy which could justify reading into the Act a construction so at variance with its history. The policy of the copyright law, we are told, is to protect the author—if need be, from himself—and a construction under which the author is powerless to assign his renewal interest furthers this policy. We are asked to recognize that authors are congenitally irresponsible, that frequently they are so sorely pressed for funds that they are willing to sell their work for a mere pittance, and therefore assignments made by them should not be upheld. It is important that we distinguish between two problems implied in these situations: whether, despite the contrary direction given to this legislation by the momentum of history, we are to impute to Congress the enactment of an absolute statutory bar against assignments of authors' renewal interests, and secondly, whether, although there be no such statutory bar, a particular assignment should be denied enforcement by the courts because it was

made under oppressive circumstances. The first question alone is presented here, and we make no intimations upon the other. It is one thing to hold that the courts should not make themselves instruments of injustice by lending their aid to the enforcement of an agreement where the author was under such coercion of circumstances that enforcement would be unconscionable. Cf. *Union Pacific R. Co. v. Public Service Comm'n.*, 248 U. S. 67, 70; *Loneragan v. Buford*, 148 U. S. 581, 589-91; *Snyder v. Rosenbaum*, 215 U. S. 261, 265-66; *Post v. Jones*, 19 How. 150, 160; *The Elfrida*, 172 U. S. 186, 193-94. It is quite another matter to hold, as we are asked in this case, that regardless of the circumstances surrounding a particular assignment, no agreements by authors to assign their renewal interests are binding.

It is not for courts to judge whether the interests of authors clearly lie upon one side of this question rather than the other. If an author cannot make an effective assignment of his renewal, it may be worthless to him when he is most in need. Nobody would pay an author for something he cannot sell. We cannot draw a principle of law from the familiar stories of garret poverty of some men of literary genius. Even if we could do so, we cannot say that such men would regard with favor a rule of law preventing them from realizing on their assets when they are most in need of funds. Nor can we be unmindful of the fact that authors have themselves devised means of safeguarding their interests. We do not have such assured knowledge about authorship, and particularly about song writing, or the psychology of gifted writers and composers, as to justify us as judges in importing into Congressional legislation a denial to authors of the freedom to dispose of their property possessed by others. While authors may have habits making for intermittent want, they may have no less a spirit of independence which would resent treatment of them as wards under guardianship of the law.

We conclude, therefore, that the Copyright Act of 1909 does not nullify agreements by authors to assign their renewal interests. We are fortified in this conclusion by reference to the actual practices of authors and publishers with respect to assignments of renewals, as disclosed by the records of the Copyright Office. Since the enactment of the Copyright Act of 1870, 16 Stat. 198, 213, assignments of copyrights must be recorded in the office of the Register of Copyrights. The records of the Copy-

right Office, we are advised, show that during the period from July, 1870, to July, 1871, the first period in which assignments were recorded in the Office, 223 assignments were registered. Of these 14 were assignments of renewal interests. Similarly, during the first six months of 1909, immediately preceding the enactment of the Copyright Act of that year, 304 assignments were recorded, and of these 62 were assignments of renewal interests. In the six-month period following the enactment of the Copyright Act of 1909, there was no significant change: 404 assignments, of which 68 were transfers of renewals. And, to round out the picture, in the most recent complete volume of records (covering the period from January 27, 1943, to February 12, 1943), 135 assignments were recorded, and of these 29 were assignments of renewals. Many assignments have thus been entered into in good faith upon the assumption that they were valid and enforceable.

In addition to all other books and pamphlets relevant to our problem, we have consulted all of the twenty treatises on the American law of copyright available at the Library of Congress. Eight of these state, without qualification, that an author can effectively agree to assign his renewal interest before it has been secured;<sup>5</sup> two state the rule with some reservations;<sup>6</sup> ten are either silent or ambiguous.<sup>7</sup> And the forms of assignment of copyright in treatises and standard form-books generally contain a provision designed to transfer the renewal interest.<sup>8</sup>

<sup>5</sup> Curtis on Copyright (1847) 235; Drone on Copyright (1879) 226-32; Howell, Copyright Law (1942) 108; 2 Morgan, Law of Literature (1873) 229-30; Spalding, Law of Copyright (1878) 111; Macgillivray, Law of Copyright (1902) 266-67; Wittenberg, Protection and Marketing of Literary Property (1937) 45; Ladas, International Protection of Literary and Artistic Property (1938) 772-73.

<sup>6</sup> DeWolf, Outline of Copyright Law (1925) 65-66; Weil, American Copyright Law (1917) 365-66.

<sup>7</sup> Amdur, Copyright Law and Practice (1936) 540-41; Frohlich and Schwartz, Law of Motion Pictures (1918) 548-49; Marchetti, Law of Stage, Screen, and Radio (1936) 67; Bowker, Copyright—Its History and Its Law (1912) 117, 438; Bump, Law of Patents, Trade-marks, Labels, and Copyrights (2d ed. 1884); Elfreth, Patents, Copyrights, and Trade-marks (1913); Graham, Patents, Trademarks and Copyrights (2d ed. 1921); Law, Copyright and Patent Laws of the United States, 1780-1870 (3d ed. 1870); Copinger, Law of Copyright (7th ed. 1936); Shafter, Musical Copyright (2d ed. 1939) 174.

<sup>8</sup> Wittenberg, Protection and Marketing of Literary Property (1937) 195, 261; Shafter, Musical Copyright (2d ed. 1939) 577; Gordon, Annotated Forms of Agreement (1923) 32; 6 Winslow, Forms of Pleading and Practice (3d ed. 1934) § 2267, pp. 501-02; Birdseye, Encyclopedia of General Business and Legal Forms (1924) 280-81; Amdur, Copyright Law and Practice (1936) 836; Church, Legal and Business Forms (2d ed. 1925) 344.

The available evidence indicates, therefore, that renewal interests of authors have been regarded as assignable both before and after the Copyright Act of 1909. To hold at this late date that, as a matter of law, such interests are not assignable would be to reject all relevant aids to construction.

*Affirmed.*

Mr. Justice RUTLEDGE took no part in the consideration or decision of this case.

Mr. Justice BLACK, Mr. Justice DOUGLAS, and Mr. Justice MURPHY conclude that the analysis of the language and history of the copyright law in the dissenting opinion of Judge Frank in the court below, 125 F. 2d 949, 954, demonstrates a Congressional purpose to reserve the renewal privilege for the personal benefit of authors and their families. They believe the judgment below should be reversed.